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Protecting the First Amendment Rights of Video Games from Lanham Act and Right of Publicity Claims

Yen-Shyang Tseng

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Protecting the First Amendment Rights of Video Games from Lanham Act and Right of Publicity Claims

Yen-Shyang Tseng*

Abstract

In 2013 and 2015, the Ninth Circuit decided two nearly identical cases in which professional football players alleged a video game publisher used their likenesses without authorization in a game that simulates real football games. One plaintiff brought a false endorsement claim under the Lanham Act, while others brought state law right of publicity claims. That made all the difference. The Ninth Circuit found the First Amendment protected the game against the false endorsement claim, but not against the right of publicity claims. These contradictory results stem from court's application of the Rogers v. Grimaldi test to Lanham Act claims and the transformative use test to right of publicity claims. A review of both lines of precedent in the video game context and a comparison of the cases with each other and to cases involving traditional forms of expressive works reveal two problems that must be addressed. First, many courts fail to view video games as expressive works equal to books, television shows, and films, and instead view them as products and merchandise like lithographs and t-shirts. Second, the transformative use test suffers from subjectivity and fails to properly recognize First Amendment protection over video games aiming for realism. This article proposes resolving both problems by applying the Rogers test to both Lanham Act and right of publicity claims.

* Appellate attorney at Horvitz & Levy LLP in Burbank, California. The opinions expressed in this article are mine. My firm handles California and Ninth Circuit appeals and might have represented parties or amici curiae in some cases discussed in this article, but I have not been involved in any such cases. Thanks to the editors of the *Pepperdine Law Review* and to all friends of Purple Poring.

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I. INTRODUCTION

Lawsuits against video game publishers over the use of marks and likenesses have proliferated with the recent meteoric growth of the video game and esports industries.¹ In just the past decade, Activision Blizzard faced at least three lawsuits over its use of marks or likenesses in the *Call of Duty* franchise.² Meanwhile, Electronic Arts has faced numerous lawsuits over its use of the likenesses of college and professional athletes' likenesses in *Madden NFL* and *NCAA Football*.³ More recently, Epic Games and Take-Two have faced a flurry of cases over their use of dance moves in *Fortnite* and *NBA 2K*.⁴ An analysis of Lanham Act and right of publicity cases in the video game context reveals two problems. First, courts remain reluctant to view video games as expressive works equal to traditional entertainment media; instead, they view them as products and merchandise like lithographs and t-shirts. Second, even when the facts are nearly identical, the results in these cases can differ depending entirely on the legal theory alleged by a plaintiff.

These problems stem in part from the different tests applied to Lanham Act claims and right of publicity claims. In cases arising from the Lanham Act, courts apply the Second Circuit's *Rogers v. Grimaldi* test to balance the plaintiff's rights with the defendant's First Amendment rights.⁵ The *Rogers* test has upheld video game publishers' First Amendment rights, leading to Activision's victories in the *Call of Duty* cases and EA's win in one case involving *Madden NFL*.⁶ By contrast, in right of publicity cases, courts apply the transformative use test.⁷ And unlike the *Rogers* test, the transformative

1. See generally Yen-Shyang Tseng, *The Principles of Esports Engagement: A Universal Code of Conduct?*, 27 J. INTEL. PROP. L. 209, 211–15 (2020) (discussing growth of video games and esports).

2. See *infra* note 165 and accompanying text.

3. See, e.g., *infra* Sections III.D.3, IV.D.1–3.

4. See *infra* Section IV.V.3 (discussing lawsuits filed against Epic Games and Take-Two).

5. See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d. Cir. 1989).

6. See *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013) (holding in favor of Electronic Arts when applying the *Rogers* test); *AM General, LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467 (S.D.N.Y. 2020) (granting a motion for summary judgment and dismissing trademark infringement claims after applying Lanham Act analysis); *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1136 (N.D. Cal. 2014) (holding in favor of Activision based on use of the *Rogers* test); *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 898–901 (C.D. Cal 2013) (holding in favor of Activision based on use of the *Rogers* test).

7. See *infra* Section IV.B.

use test has failed to adequately respect the First Amendment, leading to several of EA's losses in cases involving *Madden NFL* and *NCAA Football*.⁸ Further, the subjectivity of the transformative use test has allowed courts to make the inexplicable distinction between video games and other forms of expressive works.

Commentators have acknowledged the problem arising from the courts reaching inconsistent results.⁹ Several have advocated for greater protection for trademark owners and individuals by importing the transformative use test applied in right of publicity cases to Lanham Act cases.¹⁰ This article proposes applying the *Rogers* test to both Lanham Act and right of publicity claims to adequately protect the First Amendment rights of video games. Doing so would satisfy the strict scrutiny analysis that should be applied to the right of publicity as a content-based restriction on speech. And it would recognize that video games are expressive works like books, television shows, and films—not products or merchandise like lithographs and t-shirts. Yet at the same time, it would properly protect both mark owners and individuals whose marks or likenesses have been misappropriated for commercial use.

II. THE FIRST AMENDMENT'S PROTECTION OF ENTERTAINMENT

The First Amendment has long protected entertainment as a form of expression. In 1948, the U.S. Supreme Court held that the First Amendment protected magazines, finding “[t]he line between the informing and the entertaining is too elusive for the protection of [a free press]. Everyone is familiar with instances of propaganda through fiction. What is one man’s amusement, teaches another’s doctrine.”¹¹ Four years later, the Court extended First Amendment protection to motion picture films, finding “[t]he importance of motion pictures as an organ of public opinion is not lessened by the fact that they are designed to entertain as well as to inform.”¹² And in the first and only right of publicity case the Court heard, it reiterated that

8. See, e.g., *infra* Sections IV.C.2., IV.D.1–3.

9. See, e.g., Arlen Papazian, *Let's Stop Play Games: A Consistent Test for Unlicensed Trademark Use and the Right of Publicity in Video Games*, 8 WM. & MARY BUS. L. REV. 577, 592–96 (2017).

10. See *id.* at 596–603.

11. *Winters v. New York*, 333 U.S. 507, 510 (1948); see also *Univ. of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.*, 256 N.Y.S.2d 301, 307 (N.Y. App. Div. 1965) (holding the First Amendment protects forms of expression even if they are only for entertainment), *aff'd*, 207 N.E.2d 508 (N.Y. 1965).

12. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952).

“[t]here is no doubt that entertainment, as well as news, enjoys First Amendment protection.”¹³

The Court also made it clear that the First Amendment protects entertainment even though entertainment is often created for profit: “That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment. We fail to see why operation for profit should have any different effect in the case of motion pictures.”¹⁴ Likewise, the California Supreme Court held, “[w]hen expression protected by the First Amendment is involved, ‘[i]t is of course no matter that the dissemination takes place under commercial auspices.’”¹⁵ In the court’s seminal right of publicity decision in 1979, it reiterated that “[t]he First Amendment is not limited to those who publish without charge. Whether the activity involves newspaper publication or motion picture production, it does not lose its constitutional protection because it is undertaken for profit.”¹⁶

Many decades later, in the era of lawsuits challenging regulations over “violent” games, lower courts began to recognize the First Amendment’s protection of video games.¹⁷ The Eighth Circuit saw “no reason why the pictures, graphic design, concept art, sounds, music, stories, and narrative present in video games are not entitled to a similar protection” as paintings,

13. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977).

14. *Joseph Burstyn, Inc.*, 343 U.S. at 501–02; *see also* *Time, Inc. v. Hill*, 385 U.S. 374, 397 (1967) (affirming the principle that an article being produced for trade purposes does not prevent it from being considered a protected form of expression).

15. *Weaver v. Jordan*, 411 P.2d 289, 297 (Cal. 1966) (quoting *Smith v. People of California*, 361 U.S. 147, 150 (1959)).

16. *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 459 (Cal. 1979) (Bird, J., concurring). Chief Justice Bird’s concurrence was endorsed by three other justices and therefore “commanded the support of the majority of the court.” *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802–03, n.7 (Cal. 2001).

17. *See, e.g.*, *Video Software Dealers Ass’n v. Schwarzenegger*, 556 F.3d 950, 953 (9th Cir. 2009) (holding a California legislative act seeking to limit sales of violent video games to minors was an invalid infringement on First Amendment rights), *aff’d sub nom*, *Brown v. Entm’t Merchants Ass’n*, 564 U.S. 786 (2011); *Interactive Dig. Software Ass’n v. St. Louis Cty.*, 329 F.3d 954, 958 (8th Cir. 2003) (upholding the First Amendment rights of violent video games against a law restricting sale of these games to minors); *James v. Meow Media Inc.*, 300 F.3d 683, 696 (6th Cir. 2002) (extending First Amendment protections to video game when plaintiff sought tort liability against game producers for communicative aspects of the game); *Am. Amusement Mach. Ass’n v. Kendrick*, 244 F.3d 572, 579–80 (7th Cir. 2001) (recognizing First Amendment protections of video games against city ordinance limiting access of minors to violent games).

music, and literature.¹⁸ The Ninth Circuit found that “story-laden video games . . . are similar to movies, which the [Supreme] Court has long held are protected expression notwithstanding their ability to entertain as well as inform.”¹⁹ In 2011, the U.S. Supreme Court affirmed the First Amendment’s protection of video games, holding:

Like the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world). That suffices to confer First Amendment protection.²⁰

Nevertheless, recent decisions and commentary by lower courts sometimes suggest a view of video games as less deserving of First Amendment protection than other expressive works.²¹ These courts often view video games more as products or merchandise rather than as expressive works.²² For example, the 2018 California Court of Appeal decision in *de Havilland v. FX Networks, LLC* distinguished “expressive works such as films, plays, and television programs” from “products and merchandise such as T-shirts and lithographs, greeting cards, and *video games*, or

18. *Interactive Dig. Software Ass’n*, 329 F.3d at 957 (comparing these elements of video games to the “painting of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll”).

19. *Video Software Dealers Ass’n*, 556 F.3d at 958 n.11.

20. *Brown*, 564 U.S. at 790.

21. See generally William K. Ford, *So Are Games Coffee Mugs or What? Games and the Right of Publicity Revisited*, 19 UIC REV. INTELL. PROP. L. 178 (2020) [hereinafter *So Are Games Coffee Mugs or What?*] (discussing how video games are still treated like celebrity memorabilia but predicting a shift in the way courts will treat them in the near future); William K. Ford, *Restoring Rogers: Video Games, False Association Claims, and the “Explicitly Misleading” Use of Trademarks*, 16 J. MARSHALL REV. INTELL. PROP. L. 306, 310–311 (2017) [hereinafter *Restoring Rogers*] (discussing the evolution of different approaches to First Amendment rights and video games in the Ninth Circuit and the specific issue of judges seeing video games not as distinguishable from t-shirts and mugs); William K. Ford & Raizel Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA HIGH TECH. L. J. 1 (2012) (arguing that the evolution of games calls for a new approach in rights of publicity claims that treats games as more than memorabilia).

22. See *So Are Games Coffee Mugs or What?*, *supra* note 21, at 179 (noting that lower court decisions after *Brown v. Entm’t Merchants Ass’n* have “failed to drag games out of the merchandise category for purposes of the right of publicity”); Ford & Liebler, *supra* note 21, at 89 (“Games are treated differently than newspapers, magazines, books, and films because these courts perceive games as an inferior medium of expression, i.e., as merchandise like coffee mugs and T-shirts.”).

advertisements for products and merchandise.”²³ Similarly, during a 2014 oral argument in *Davis v. Electronic Arts Inc.*,²⁴ when EA’s counsel sought to distinguish video games and other expressive works from greeting cards and t-shirts, a judge commented that “99% of greeting cards, it seems to me, have pictures and they have writing and they’re at least as expressive as a video game, probably more so.”²⁵ The court’s opinion ultimately distinguished the case before it involving a video game from “cases involving other kinds of expressive works.”²⁶ Similar examples appear later in this article.²⁷

III. CASES BALANCING THE FIRST AMENDMENT’S PROTECTION OF VIDEO GAMES WITH TRADEMARK RIGHTS

A. *Federal Trademark Rights: The Lanham Act*

The Lanham Act, 15 U.S.C. § 1051 et seq., establishes federal trademark law.²⁸ Broadly speaking, “[a] trademark is a word, phrase or symbol that is used to identify a manufacturer or sponsor of a good or the provider of a service.”²⁹ Among other things, the Lanham Act prohibits trademark infringement, false designations of origin, and false endorsement.³⁰ Section 1114(1)(a) prohibits the use of a registered trademark “in connection with the sale, offering for sale, distribution, or advertising of any goods or services on

23. 230 Cal. Rptr. 3d 625, 636, 641 (Cal. Ct. App. 2018) (emphasis added) (internal citations omitted), *review denied* (July 11, 2018), *cert. denied*, 139 S. Ct. 800, 202 L. Ed. 2d 572 (2019).

24. 775 F.3d 1172 (9th Cir. 2015).

25. Oral Argument at 9:33, *Davis v. Electronic Arts, Inc.*, 775 F.3d 1172 (9th Cir. 2015) (No. 12-15737), https://www.youtube.com/watch?v=_hlz3cx6lWQ; *see also Restoring Rogers*, *supra* note 21, at 311 (emphasis omitted) (explaining why the comparison of video games to greeting cards is striking).

26. *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1279, n.10 (9th Cir. 2013).

27. *See infra* Section V.B.

28. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:4 (5th ed. 2020) [hereinafter TRADEMARKS AND UNFAIR COMPETITION]; *see also* 3 TRADEMARKS AND UNFAIR COMPETITION at § 22:1–22:1.50 (“Federal trademark law does not preempt state trademark law,” and most states have adopted trademark law similar to federal trademark law.). This article focuses on federal law. *See infra* Sections III.C–D, IV.D, V.C.

29. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); *see also* 15 U.S.C. § 1127 (2012) (defining trademark, service mark, and other related terms); TRADEMARKS AND UNFAIR COMPETITION, *supra* note 28, § 3:1 (defining a trademark as “a designation used to identify and distinguish the source of goods and services of a person or company”).

30. *See* 15 U.S.C. §§ 1114, 1125 (2016).

or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.”³¹ Section 1125(a)(1) prohibits the use of:

Any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities.³²

Trademark rights serve dual purposes: they “protect consumers from deception and confusion over trademarks” and they “protect the plaintiff’s infringed trademark as property.”³³ In *Two Pesos, Inc. v. Taco Cabana, Inc.*, Justice Stevens reviewed the Senate Report for the Lanham Act and found two stated goals:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.³⁴

31. 15 U.S.C. § 1114(1)(a).

32. 15 U.S.C. § 1125(a)(1)–(a)(1)(B) (2016).

33. See TRADEMARKS AND UNFAIR COMPETITION, *supra* note 28, § 2:2. As McCarthy explains, however, commentators have disagreed over whether the historical purpose of trademark law is to protect the consumer from confusion or to protect the mark owner’s property right. See TRADEMARKS AND UNFAIR COMPETITION, *supra* note 28, § 2:1.

34. 505 U.S. 763, 782, n.15 (Stevens, J., concurring) (quoting S. REP. NO. 1333, at 3 (1946)); see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (describing the “basic objectives of trademark law”). Many articles have discussed the purposes of trademark law. See, e.g., Ned Snow, *Free Speech & Disparaging Trademarks*, 57 B.C. L. REV. 1639, 1666–77 (2016); Noa Tai, *Aesthetic*

The Ninth Circuit has described the “core purpose” of trademark law as “avoiding confusion in the marketplace” by “preventing others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner.”³⁵ Avoiding consumer confusion serves the two goals of “assur[ing] a potential customer” that the item with the mark “is made by the same producer as other similarly marked items” and assuring the producer that “it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.”³⁶

B. The Second Circuit’s Rogers v. Grimaldi test

In 1989, the Second Circuit issued its seminal decision in *Rogers v. Grimaldi*, which established the test courts would apply to balance the Lanham Act with the First Amendment for decades to come.³⁷ Actress Ginger Rogers sued an Italian filmmaker over the film *Ginger and Fred*, which told “the story of two fictional cabaret performers” who imitated Rogers and Fred Astaire and “became known in Italy as Ginger and Fred.”³⁸ Rogers alleged the filmmaker violated the Lanham Act, her right of publicity, and her right to privacy.³⁹ She argued the filmmaker violated the Lanham Act by “creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film.”⁴⁰

The Second Circuit recognized the conflict between the Lanham Act’s protection of consumers and the First Amendment’s protection of artistic expressions: “Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection,” but those works are “also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some

Functionality: Trademark Law’s Red Herring Doctrine, 22 TEX. INTELL. PROP. L. J. 25, 28–30 (2013).

35. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); *see also Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1067 (9th Cir. 2006) (“The principal role of trademark law is to ensure that consumers are able to identify the source of goods.”).

36. *Qualitex*, 514 U.S. at 164; *Au-Tomotive Gold*, 457 F.3d at 1067 (noting that “[p]rotecting the source-identifying role of trademarks serves [these] two goals”).

37. *See* 875 F.2d 994, 999 (2d Cir. 1989).

38. *Id.* at 996–97. As the Second Circuit explained, “Rogers and the late Fred Astaire are among the most famous duos in show business history” who “established themselves as paragons of style, elegance, and grace.” *Id.* at 996.

39. *Id.* at 997.

40. *Id.*

government regulation.”⁴¹ The court concluded that, “[b]ecause overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”⁴²

The court then analyzed what test should apply.⁴³ It rejected the “alternative means” test, where “First Amendment concerns are implicated only where a title is so intimately related to the subject matter of a work that the author has no alternative means of expressing what the work is about.”⁴⁴ Instead, the court found “the [Lanham Act] should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁴⁵ “That balance,” the court said, “will normally not support application of the [Lanham] Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”⁴⁶

The Second Circuit explained the rationale behind this two-part test, that “[a] misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest.”⁴⁷ Moreover, a title with “minimal artistic relevance but [that] was explicitly misleading as to source or content” could still violate the Lanham Act.⁴⁸ But when “the title is artistically relevant to the work . . . the slight risk that such use of a celebrity’s name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression, and the Lanham Act is not applicable.”⁴⁹

Applying this test, the court found “[t]he title ‘Ginger and Fred’ surpass[e]d the minimum threshold of artistic relevance to the film’s content” because “the central characters in the film are nicknamed ‘Ginger and Fred,’ and these names are not arbitrarily chosen just to exploit the publicity value

41. *Id.*

42. *Id.* at 998.

43. *Id.* at 998–1000.

44. *Id.* at 998. The Second Circuit had previously applied the “no alternative means” test in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

45. *Rogers*, 875 F.2d at 999.

46. *Id.*

47. *Id.*

48. *Id.*

49. *See id.* at 1000.

of their real life counterparts but instead have genuine relevance to the film’s story.”⁵⁰ It then found the title was not misleading because it “contains no explicit indication that Rogers endorsed the film or had a role in producing it,” it “is entirely truthful as to its content in referring to the film’s fictional protagonists who are known to their Italian audience as ‘Ginger and Fred,’” and it “has an ironic meaning that is relevant to the film’s content.”⁵¹ In short, any risk that some members of the public might be misled “is outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.”⁵² Thus, the First Amendment protected the film’s title.⁵³

C. *Development of the Rogers Test in the Ninth Circuit and Its Application to Video Games*

Many courts would later adopt the *Rogers* test and extend it to the content of expressive works.⁵⁴ The Ninth Circuit, however, has led the charge and developed the most robust jurisdiction on the application of the *Rogers* test to video games.⁵⁵ This is perhaps unsurprising given the number of major video game publishers in California, including Riot Games,⁵⁶ Activision Blizzard,⁵⁷ and Electronic Arts.⁵⁸

1. *Mattel, Inc. v. MCA Records* and *Mattel, Inc. v. Walking Mountain Productions*

The Ninth Circuit first adopted the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.*, in which Mattel, the maker of the Barbie dolls, sued MCA

50. *Id.* at 1001.

51. *Id.*

52. *Id.*

53. *Id.* at 1005.

54. See Daniel Jacob Wright, *Explicitly Explicit: The Rogers Test and the Ninth Circuit*, 21 J. INTELL. PROP. L. 193, 203–06 (2013).

55. *Id.* at 209, 212–13.

56. *We Are Rioters*, RIOT GAMES, <https://www.riotgames.com/en/who-we-are/values> (last visited Oct. 2, 2020) (“Riot is headquartered in Los Angeles, California.”).

57. *About Us*, ACTIVISION BLIZZARD, <https://www.activisionblizzard.com/location> (last visited Oct. 2, 2020) (identifying corporate headquarters in Santa Monica, California).

58. *About EA*, EA, <https://www.ea.com/about> (last visited Oct. 2, 2020) (identifying global headquarters in Redwood City, California).

Records (and others) for trademark infringement over the song *Barbie Girl* by Aqua.⁵⁹ As Judge Kozinski described, Barbie dolls represent “a symbol of American girlhood, a public figure who graces the aisles of toy stores throughout the country and beyond,”⁶⁰ while “Aqua [was] a Danish band that has, as yet, only dreamed of attaining Barbie-like status.”⁶¹ “In the song, one bandmember impersonates Barbie, singing in a high-pitched, doll-like voice; another bandmember, calling himself Ken, entices Barbie ‘to go party.’”⁶²

The Ninth Circuit agreed with the Second Circuit’s analysis in *Rogers* and adopted the *Rogers* test as its own.⁶³ Applying the test, the court first found “the use of Barbie in the song title clearly is relevant to the underlying work,” since “the song is about Barbie and the values Aqua claims she represents.”⁶⁴ The court then found “[t]he song title [did] not explicitly mislead as to the source of the work [because] it does not, explicitly or otherwise, suggest that it was produced by Mattel.”⁶⁵ The court noted that “[the] *only* indication that Mattel might be associated with the song is the use of Barbie in the title,” and that alone could not be enough or the *Rogers* test would be rendered a nullity.⁶⁶

A year after *MCA Records*, the Ninth Circuit reiterated its adoption of the *Rogers* test in *Mattel, Inc. v. Walking Mountain Productions*.⁶⁷ Mattel had sued photographer Thomas Forsythe over “a series of [seventy-eight] photographs entitled ‘Food Chain Barbie,’ . . . [which] depicted Barbie in various absurd and often sexualized positions.”⁶⁸ “Forsythe describe[d] the message behind his photographic series as an attempt to ‘critique[] the objectification of women associated with [Barbie], and [] [to] lambast[] the conventional beauty myth and the societal acceptance of women as objects because this is what Barbie embodies.’”⁶⁹

The Ninth Circuit found Forsythe’s work was a parody entitled to First

59. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).

60. *Id.* at 898.

61. *Id.* at 899.

62. *Id.* at 899.

63. *Id.* at 902.

64. *Id.*

65. *Id.*

66. *Id.*

67. *See Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003).

68. *Id.* at 796.

69. *Id.* (alterations in original).

Amendment protection,⁷⁰ and then went on to apply the *Rogers* test.⁷¹ As for artistic relevance, the court found “Forsythe’s use of the Barbie mark is clearly relevant to his work.”⁷² As for whether the use was explicitly misleading, the court found “[t]he Barbie mark in the titles of Forsythe’s works and on his website accurately describe[s] the subject of the photographs, which in turn, depict Barbie and target the doll with Forsythe’s parodic message.”⁷³

2. *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*

Like *Rogers*, *MCA Records* and *Walking Mountain* involved titles of expressive works—the *Barbie Girl* song and the *Food Chain Barbie* photograph series.⁷⁴ And *Walking Mountain* expressly left open the question whether the Ninth Circuit would apply the *Rogers* test to the body of an expressive work.⁷⁵

Five years after *Walking Mountain*, the Ninth Circuit applied the *Rogers* test both to the body of an expressive work and to the use of a trademark in a video game in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*⁷⁶ There, the operator of the strip club *Play Pen Gentlemen’s Club* in East Los Angeles sued Rockstar Games, a subsidiary of Take-Two Interactive, over the depiction of a strip club in *Grand Theft Auto: San Andreas*.⁷⁷

The *Grand Theft Auto* “[s]eries is known for an irreverent and sometimes crass brand of humor, gratuitous violence and sex, and overall seediness.”⁷⁸ “Each game . . . takes place in one or more dystopic, cartoonish cities modeled after actual American urban areas.”⁷⁹ *San Andreas* takes place in cities “based on Los Angeles, San Francisco, and Las Vegas.”⁸⁰ Los Santos—the city based

70. *Id.* at 801–03.

71. *Id.* at 807. In doing so, the court placed heavy emphasis on Barbie’s “cultural significance,” just as it had done in *MCA*. *Id.* (“Where a mark assumes such cultural significance, First Amendment protections come into play. . . . As we determined in *MCA*, Mattel’s ‘Barbie’ mark has taken on such a role in our culture.”).

72. *Id.*

73. *Id.*

74. *See supra* Part C.1.

75. *See Walking Mountain*, 353 F.3d at 808–09, nn.14 & 17.

76. 547 F.3d 1095, 1099 (9th Cir. 2008).

77. *Id.* at 1096–98.

78. *Id.* at 1096.

79. *Id.* at 1097.

80. *Id.*

on Los Angeles—“mimics the look and feel of actual Los Angeles neighborhoods” by populating the city “with [] liquor stores, ammunition dealers, casinos, pawn shops, tattoo parlors, bars, and strip clubs.”⁸¹ In East Los Santos, “the [g]ame’s version of East Los Angeles,” Rockstar included “variations on the businesses and architecture of the real thing, including a virtual, cartoon-style strip club known as the ‘Pig Pen.’”⁸² ESS argued that Rockstar’s depiction of the Pig Pen used the Play Pen’s “distinctive logo and trade dress” and “created a likelihood of confusion among consumers as to whether ESS has endorsed, or is associated with, the video depiction” of the club.⁸³

The Ninth Circuit first found that, while the *Rogers* test “traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work.”⁸⁴ The court then applied the test.⁸⁵ It clarified that “the level of [artistic] relevance merely must be above zero” to merit First Amendment protection.⁸⁶ The court found it irrelevant whether the Play Pen itself had any cultural significance.⁸⁷ The distinctiveness of East Los Angeles “[lay] in its ‘look and feel,’” which was “relevant to Rockstar’s artistic goal . . . to develop a cartoon-style parody of East Los Angeles.”⁸⁸ The court concluded that “[p]ossibly the only way, and certainly a reasonable way, to do that is to recreate a critical mass of the businesses and buildings that constitute it”—“includ[ing] a strip club similar in look and feel to the Play Pen.”⁸⁹

Turning to the explicitly misleading prong, the court noted the analysis “points directly at the purpose of trademark law, namely to ‘avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping customers into buying a product they mistakenly believe is sponsored by the trademark owner.’”⁹⁰ The court reiterated that mere use of the

81. *Id.*

82. *Id.*

83. *Id.* at 1098.

84. *See id.* at 1099.

85. *Id.* at 1099–1100.

86. *Id.* at 1100.

87. *Id.*

88. *Id.*

89. *Id.*

90. *Id.*

trademark was not enough; instead, the relevant question was “whether the Game would confuse its players into thinking that the Play Pen [was] somehow behind the Pig Pen or that it sponsor[ed]” the game.⁹¹ It found *San Andreas* and the Play Pen had “nothing in common” other than “offer[ing] a form of lowbrow entertainment.”⁹² Nothing suggested anyone would reasonably believe that ESS produced the game or that Rockstar operated a strip club.⁹³ Moreover, a player would not “think ESS had provided [any] expertise, support, or unique strip-club knowledge it possesses to the production of the game.”⁹⁴ “[T]he Game [did] not revolve around running or patronizing a strip club,” and “[w]hatever one can do at the Pig Pen seems quite incidental to the overall story of the Game.”⁹⁵ Finally, “[a] reasonable consumer would not think a company that owns one strip club in East Los Angeles, which is not well known to the public at large, also produces a technology sophisticated video game like *San Andreas*.”⁹⁶

3. Confusion Within the District Courts

After *ESS*, some confusion developed in the district courts over three issues: (1) whether the *Rogers* test applies only to trademarks that have achieved cultural significance, (2) whether a defendant must use the mark to refer to the plaintiff for it to have artistic relevance, and (3) the role of the likelihood of confusion test in the *Rogers* analysis.⁹⁷ Two decisions from the Northern District of California illustrate the difficulties lower courts had in applying the *Rogers* test.

In *Rebellion, LLC v. Perez*, a reggae band using the name “Rebellion” in its business and in a self-titled album sued Armando Perez (known as Pitbull) because he used the word rebellion in the title of a record.⁹⁸ The district court denied Pitbull’s summary judgment motion based on the *Rogers* test on two relevant grounds.⁹⁹

91. *Id.*

92. *Id.*

93. *Id.*

94. *Id.*

95. *Id.*

96. *Id.* at 1100–01 (italics added).

97. See Wright, *supra* note 54, at 209–13.

98. 732 F. Supp. 2d 883, 885–886 (N.D. Cal. 2010).

99. *Id.* at 889. Relying on footnote 5 in *Rogers*, the court also held the *Rogers* test did not apply because the case before it involved two confusingly similar titles. *Id.* at 888. While a full discussion

First, citing *MCA Records* and *Walking Mountain*, the district court found the Ninth Circuit had “placed an important threshold limitation upon its application: plaintiff’s mark must be of such cultural significance that it has become an integral part of the public’s vocabulary.”¹⁰⁰ The Ninth Circuit’s decisions in *MCA Records* and *Walking Mountain* heavily emphasized Barbie’s cultural significance, and Judge Kozinski suggested the conflict between the Lanham Act and the First Amendment “arises when trademarks transcend their identifying purpose” and “enter our public discourse and become an integral part of our vocabulary.”¹⁰¹ In *Rebellion*, because neither the word “rebellion” nor plaintiff’s mark had cultural significance, the court found “no First Amendment rights are implicated and the *Rogers* test is inapplicable.”¹⁰²

Second, the court surveyed “every federal court of appeals case addressing the artistic adoption of plaintiff’s non-generic mark” and found that a defendant’s use of a mark must “be with reference to the meaning associated with *plaintiff’s* mark” to have artistic relevance under the first part of the *Rogers* test.¹⁰³ In other words, the court found Pitbull had to show “he intended to refer to plaintiff when he used plaintiff’s mark,” and he did not do so.¹⁰⁴

of the distinction between titles and contents of expressive works is beyond the scope of this article, this holding does not withstand scrutiny. See Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 TRADEMARK REP. 833, 846–47 (2019). The Second Circuit clarified that the *Rogers* test applies to cases involving titles alleged to be confusingly similar but that the explicitly misleading prong would include a likelihood of confusion analysis. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989); *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993). One district court within the Ninth Circuit also found the *Rogers* test applies to cases involving similar titles and that any similarities simply bear on the explicitly misleading prong of the test. See *CI Games S.A. v. Destination Films*, No. 2:16-cv-05719-SVW-JC, 2016 WL 9185391, at *3–5, *8–9 (C. D. Cal. Oct. 25, 2016).

100. See *Rebellion*, 732 F. Supp. 2d at 887.

101. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2000). Judge Kozinski further said that

when a trademark owner asserts a right to control how we express ourselves—when we’d find it difficult to describe the product any other way (as in the case of aspirin), or when the mark (like *Rolls Royce*) has taken on an expressive meaning apart from its source-identifying function—applying the traditional [likelihood of confusion] test fails to account for the full weight of the public’s interest in free expression.”

Id.

102. *Rebellion*, 732 F. Supp. 2d at 888.

103. *Id.* at 888–89.

104. *Id.* at 889.

In *Electronic Arts, Inc. v. Textron Inc.*, Electronic Arts (“EA”) sued Textron, the holding company of Bell’s intellectual property rights, for declaratory judgment and non-infringement over the depiction of certain Bell helicopters in EA’s *Battlefield 3*.¹⁰⁵ Textron filed counterclaims alleging trademark infringement and other claims.¹⁰⁶

The district court addressed EA’s motion to dismiss Textron’s counterclaims.¹⁰⁷ Without addressing the applicability of the *Rogers* test or the artistic relevance prong, the court focused its analysis on whether EA’s use of the helicopters was explicitly misleading as to the source and content of *Battlefield 3*.¹⁰⁸ In doing so, the court appeared to apply a likelihood of confusion analysis.¹⁰⁹ At the same time, however, the court found that Textron’s counter-complaint alleged “that the helicopters were a main selling point for the game” and “EA intended consumer confusion.”¹¹⁰

Rebellion and *Textron* raised several questions. First, does the *Rogers* test apply only to trademarks that have achieved cultural significance? Second, must the defendant’s use of the mark refer to the plaintiff? Third, does the likelihood of confusion analysis have any place in the *Rogers* test? The Ninth Circuit would later answer all three questions with a resounding “no.”

4. *Brown v. Electronic Arts, Inc.*

In 2013, the Ninth Circuit applied the *Rogers* test to a video game in *Brown v. Electronic Arts, Inc.*, where legendary former NFL player and NFL Hall of Fame member Jim Brown sued EA over the use of his likeness in the *Madden NFL* series based on a false endorsement theory.¹¹¹ This case presented the Ninth Circuit with the first opportunity to clarify the *Rogers* test after *Rebellion* and *Textron*, and after the U.S. Supreme Court’s decision in *Brown v. Entertainment Merchants Ass’n*.

105. No. C 12-00118 WHA, 2012 WL 3042668, at *1–2 (N.D. Cal. July 25, 2012).

106. *Id.* at *1.

107. *Id.* at *2.

108. *Id.* at *3.

109. *See id.* at *4 (appearing to reject EA’s contention “that the ‘likelihood of confusion’ analysis should not come into play unless the work fails the *Rogers* test”).

110. *Id.* at *5. These findings suggest the court’s somewhat muddled analysis and reference to the likelihood of confusion test might nevertheless have focused on the right question: whether EA’s use of Textron’s trademarks was explicitly misleading as to the source or content of the work. *See id.*

111. *See Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239–41 (9th Cir. 2013).

In *Madden NFL*, players “control avatars representing professional football players as those avatars participate in simulated NFL games” and “participate in other aspects of a simulated NFL by, for example, creating and managing a franchise.”¹¹² Each version of *Madden NFL* includes the NFL teams and their rosters for that year, and each avatar is designed to mirror a real player, “including the player’s name, jersey number, physical attributes, and physical skills.”¹¹³ Some versions of *Madden NFL* “also include historical and all-time teams,” where player names are not used but are nevertheless “recognizable due to the accuracy of their team affiliations, playing positions, ages, heights, weights, ability levels, and other attributes.”¹¹⁴ While EA licenses from the NFL and NFL Players Association for its use of the names and likenesses of current players, those licenses do not cover former players such as Brown, who played for the Cleveland Browns from 1957 to 1965.¹¹⁵

The Ninth Circuit began its analysis by holding that the *Rogers* test alone applies to cases balancing the Lanham Act against First Amendment rights in expressive works.¹¹⁶ The court rejected the likelihood of confusion test and the alternative means test, finding that both tests “fail[ed] to account for the full weight of the public’s interest in free expression.”¹¹⁷ As the court explained, “[t]he only relevant legal framework for balancing the public’s right to be free from consumer confusion about Brown’s affiliation with *Madden NFL* and EA’s First Amendment rights in the context of Brown’s [Lanham Act] claim is the *Rogers* test.”¹¹⁸

In reaching this result, the court discussed the Supreme Court’s recent holding in *Brown* and quipped, “[e]ven if *Madden NFL* is not the expressive equal of *Anna Karenina* or *Citizen Kane*, the Supreme Court has answered with an emphatic ‘yes’ when faced with the question of whether video games deserve the same protection as more traditional forms of expression.”¹¹⁹ The court suggested there might be a “line to be drawn between expressive video games and non-expressive video games,” but every version of *Madden NFL* is expressive because they “feature[] characters (players), dialogue (between

112. *Id.* at 1240.

113. *Id.*

114. *Id.*

115. *Id.* at 1239–40.

116. *See id.* at 1241.

117. *Id.* at 1241–42 (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002)).

118. *Id.* at 1242.

119. *Id.* at 1241.

announcers), plot (both within a particular simulated game and more broadly), and music,” as well as “[i]nteraction between the virtual world of the game and individuals playing the game.”¹²⁰

Applying the *Rogers* test, the Ninth Circuit found the use of Brown’s likeness had artistic relevance.¹²¹ The court focused on the game’s realism: “EA prides itself on the extreme realism of the games,” and the “importance of including Brown’s likeness to realistically recreate one of the teams in the game” made it obvious that his “likeness has at least some artistic relevance to EA’s work.”¹²² Moreover, the court found the “content of the *Madden NFL* games—the simulation of NFL football—is clearly related” to Brown, a former NFL player.¹²³

Next, the Ninth Circuit clarified that the key to satisfying the explicitly misleading analysis is “that the creator must *explicitly* mislead consumers.”¹²⁴ Thus, the test focuses on “whether the [use of Brown’s likeness] would confuse [*Madden NFL*] players into thinking that [Brown] is somehow behind [the games] or that [he] sponsors [EA’s] product,” as well as “whether there was an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused such consumer confusion.”¹²⁵ The use of Brown’s likeness alone did not satisfy this test, nor did evidence showing that consumers believed that Brown endorsed *Madden NFL*.¹²⁶ Instead, the court held that any “evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use.”¹²⁷

The court’s findings regarding two specific materials Brown pointed to are of interest. First, the court found EA’s statement that *Madden NFL* included “[f]ifty of the NFL’s greatest players and every All-Madden team” showed no attempt to mislead consumers because the statement was true.¹²⁸ Second, the court addressed a statement by EA officials saying “EA was able to use the images and likenesses of players because it obtained written

120. *Id.*

121. *See id.* at 1243.

122. *Id.*

123. *Id.* at 1243–44.

124. *Id.* at 1245.

125. *Id.* (quoting *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) and *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989)) (alterations in original).

126. *See id.* at 1245–46 (noting that Brown put forth several arguments to show that he satisfied the second prong of the *Rogers* test; however, his arguments were ultimately unsuccessful).

127. *Id.* at 1246.

128. *Id.* (alteration in original).

authorization from both the NFL players and the NFL.”¹²⁹ The court found this was “perhaps the closest Brown [came] to offering evidence that EA acted in an explicitly misleading manner as to Brown’s endorsement of the game,” but it had no need to address whether the statement itself could be explicitly misleading because EA made the statement only to a limited audience.¹³⁰ Thus, Brown failed to show EA explicitly misled *consumers* regarding his involvement.¹³¹

Brown clarified Ninth Circuit law on the intersection between the Lanham Act and the First Amendment in two important ways. First, by expressly rejecting the likelihood of confusion and alternative means tests, the Ninth Circuit resolved any ambiguity that *Textron* might have caused regarding the role of alternative tests in the *Rogers* analysis.¹³² Second, the court clarified that the explicitly misleading prong of the *Rogers* test requires an “explicit indication,” “overt claim,” or “explicit misstatement” causing consumer confusion.¹³³

5. *VIRAG, S.R.L. v. Sony Computer Entertainment America LLC*

Four years after *Brown*, the Ninth Circuit again applied the *Rogers* test in *VIRAG, S.R.L. v. Sony Computer Entertainment America LLC*.¹³⁴ VIRAG was an Italian company and leader in the commercial flooring business.¹³⁵ In 2004, VIRAG began sponsoring the Rally of Monza race, which takes place on the Autodromo Nazionale Monza racetrack in Monza, Italy.¹³⁶ VIRAG’s name and trademark began appearing in 2006 “on a bridge over the track on which the Rally of Monza occurs.”¹³⁷ VIRAG also sponsored a car for one of

129. *Id.* at 1247.

130. *Id.*

131. *See id.* at 1248 (noting that the district court had discretion in deciding this issue in response to a motion to dismiss).

132. *See id.* at 1241–43.

133. *Id.* at 1245 (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989)).

134. *See* 699 F. App’x 667, 668 (9th Cir. 2017). Because the Ninth Circuit issued a short memorandum opinion, this article takes the facts and analysis mainly from the Northern District of California’s order granting Sony’s motion to dismiss. *See* *VIRAG, S.R.L. v. Sony Comput. Entm’t Am. LLC*, No. 3:15-cv-01729-LB, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015), *aff’d*, 699 F. App’x 667 (9th Cir. 2017).

135. *VIRAG*, 2015 WL 5000102, at *1.

136. *Id.*

137. *Id.*

its owners, Mirco Virag, who competed in the Rally of Monza.¹³⁸

Meanwhile, Sony published the *Gran Turismo* series of racing games, which allowed players to drive simulations of real race cars on simulations of real race tracks.¹³⁹ Sony introduced the Monza track in *Gran Turismo 5*, where it also displayed VIRAG's trademark on a simulation of the bridge of the Monza track.¹⁴⁰ *Gran Turismo 6* also included the Monza track and the VIRAG mark.¹⁴¹

VIRAG sued Sony, alleging claims under the Lanham Act.¹⁴² The district court granted Sony's motion to dismiss these claims.¹⁴³ The court rejected VIRAG's argument that the games were not expressive works subject to First Amendment protection, finding that they have "characters (the race car drivers), plot (the drama of the races), and music."¹⁴⁴ The games also have "meaningful interaction between the game player and the virtual world: how else would a game player play the games? By *not* interacting with them?"¹⁴⁵ Thus, just as *Madden NFL* was an expressive work, so too were the *Gran Turismo* games.¹⁴⁶

The district court also rejected VIRAG's argument that the *Rogers* test did not apply because the VIRAG mark did not have cultural significance.¹⁴⁷ In a lengthy analysis, the court surveyed Ninth Circuit precedent from *MCA Records* to *Brown* and district court opinions from *Rebellion* to *Mil-Spec Monkey* and concluded that the *Rogers* test is not limited to culturally significant marks.¹⁴⁸

After disposing of these preliminary issues, the court applied the *Rogers* test. Focusing on the goal of realism in *Gran Turismo 5* and *Gran Turismo 6*, the court found Sony's use of the VIRAG mark had artistic relevance because

138. *Id.*

139. *See id.* at *2.

140. *See id.*

141. *Id.*

142. *Id.* at *1. VIRAG and Mirco Virag also sued Sony for violating their rights of publicity. *Id.*

143. *See id.* (dismissing VIRAG's three claims with prejudice but denying Sony's motion to dismiss Mirco Virag's request for punitive damages).

144. *Id.* at *8.

145. *Id.*

146. *Id.*

147. *See id.* at *9 (noting that the plaintiffs contended that the *Rogers* test did not apply because the VIRAG mark did not have "such cultural significance" that it has "become an integral part of our vocabulary").

148. *See id.* at *9–10.

“the games seek to provide a realistic simulation of European car racing, including by allowing players to drive on realistic simulations of European race tracks (like the Monza Track).”¹⁴⁹ The court then found “no plausible support” for VIRAG’s argument that Sony used the VIRAG mark to “explicitly mislead consumers as to the source or content of *Gran Turismo 5* or *Gran Turismo 6*.”¹⁵⁰ VIRAG’s allegation that consumers might think VIRAG “provided expertise and knowledge for the games or sponsored them” because of its “involvement in the European racing scene” was not enough, since “[t]he focus of the second prong of the *Rogers* test is on whether the defendants explicitly mislead consumers as to the source or content of the work” and VIRAG had only alleged that Sony used the VIRAG mark.¹⁵¹ The court reiterated the Ninth Circuit’s holding in *Brown* “that a defendant must give an ‘explicit indication’ or make an ‘overt claim’ or ‘explicit misstatement’ that causes consumer confusion.”¹⁵²

On appeal, the Ninth Circuit dispatched VIRAG’s arguments in a short, four paragraph memorandum opinion that included two important clarifications of the law: “The test set forth in [*Rogers*] applies regardless whether the VIRAG trademark has independent cultural significance, or Sony’s use of the trademark within the video game serves to communicate a message other than the source of the trademark.”¹⁵³ In this single sentence, the Ninth Circuit dispelled any lingering doubts that *Rebellion* might have raised on these issues.¹⁵⁴

The Ninth Circuit continues to develop the *Rogers* test to this day, but its application to video games now appears well-settled.¹⁵⁵

149. *Id.* at *11.

150. *Id.* at *12 (italics added).

151. *Id.*

152. *Id.* at *13 (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013)).

153. *VIRAG, S.R.L. v. Sony Computer Entm’t Am. LLC*, 699 F. App’x 667, 668 (9th Cir. 2017) (citations omitted).

154. See *Look Before You Leap: Trademark Decision Highlights Importance of Thorough Pre-Litigation Assessment of Case*, SPRINGUT LAW (Dec. 7, 2017), <https://www.springutlaw.com/blog/2017/12/14/trademark-decision-highlights-importance-of-thorough-pre-litigation-assessment-of-case> (“The Ninth Circuit’s affirmance rejected a controversial line of district-court cases that would have limited [the *Rogers* test] to cultural icons.”). Curiously, despite clarifying these important aspects of the *Rogers* test, the Ninth Circuit disposed of VIRAG’s appeal in an unpublished, non-precedential opinion. See *VIRAG*, 699 F. App’x at 668, n.*.

155. See discussion *supra* Section III.C. Other cases outside the video game context have further developed the *Rogers* test in the Ninth Circuit. See discussion *supra* Section III.C.3. In a case involving a television series, the Ninth Circuit expanded the *Rogers* test to apply not only to content

D. *Other Jurisdictions Applying the Rogers Test to Video Games*

Few courts outside the Ninth Circuit have addressed the *Rogers* test in the video game context. For example, despite creating the *Rogers* test more than three decades ago, the Second Circuit so far has had no opportunity to apply it in the context of video games. Nevertheless, the few decisions that do exist provide important data.

1. *AM General LLC v. Activision Blizzard, Inc.*

Since 2003, Activision has published the *Call of Duty* military action video game series, which has become one of the “most popular and well-known video game franchises in the world.”¹⁵⁶ In the *Call of Duty* games, the “player assumes control of a military soldier and fights against a computer-controlled or human-controlled opponent across a variety of computer[-]generated battlefields.”¹⁵⁷ Each game depicts military combat in a realistic wartime setting, providing players with “very realistic and convincing . . . portrayal[s] of modern combat operations.”¹⁵⁸ To provide this realism, the games use real-world locations and military organizations, uniforms, weapons, equipment, and vehicles actually used in the real world.¹⁵⁹

One of the vehicles included in the *Call of Duty* games is the Humvee.¹⁶⁰ The Humvee—the colloquial term for the High Mobility Multipurpose Wheeled Vehicle (HMMWV)—has been “the backbone of U.S. defense tactical vehicle fleets around the world” and “an essential part of U.S. military

within an expressive work, but also to promotional activities such as “appearances by cast members in other media, radio play, online advertising, live events, and the sale or licensing of consumer goods.” See *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017). *Twentieth Century Fox* will likely be relevant to video game cases in which a plaintiff alleges the unauthorized use of a mark or likeness in advertising. See *id.* Further, in a case involving the use of trademarks on greeting cards, the Ninth Circuit raised additional considerations such as whether consumers would view a mark alone as identifying the source of the expressive work, the degree to which the user and the mark owner use the marks in the same way, and the extent to which the user adds its own expressive content to the work beyond the mark itself. See *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270 (9th Cir. 2018). These considerations might make sense in the context of products such as greeting cards, but they likely will rarely apply to video games. See *id.*

156. *AM Gen. LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467, 475 (S.D.N.Y. 2020).

157. *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 890 (C.D. Cal. 2013).

158. *Id.*; see also *AM General*, 450 F. Supp. 3d at 475 (stating the “first-person shooter series . . . is characterized by its realism, cinematic set-pieces, and fast-paced multiplayer mode”).

159. See *Novalogic*, 41 F. Supp. 3d at 890.

160. See *AM General*, 450 F. Supp. 3d at 475.

operations” for decades.¹⁶¹ “From Panama to Somalia, and to this day in Iraq and Afghanistan, the Humvee has become an iconic and a ubiquitous symbol of the modern American military.”¹⁶² Nine *Call of Duty* games depict Humvees.¹⁶³

AM General, the producer of the Humvee and the owner of the Humvee and related trademarks, sued Activision.¹⁶⁴ This case represented at least the third in a series against Activision for using trademarks in the *Call of Duty* series.¹⁶⁵ In March 2020, the Southern District of New York applied the *Rogers* test and granted Activision’s motion for summary judgment.¹⁶⁶

The court recognized the artistic relevance requirement is “real, [but] not unduly rigorous out of the understanding that the ‘overextension of Lanham Act restrictions might intrude on First Amendment values.’”¹⁶⁷ Activision’s use of the Humvee marks had artistic relevance because “[f]eaturing actual vehicles used by military operations around the world in video games about simulated modern warfare surely evokes a sense of realism and lifelikeness to the player who ‘assumes control of a military soldier and fights against a computer-controlled or human-controlled opponent across a variety of computer-generated battlefields.’”¹⁶⁸ In short, the court found, “[i]f realism is an artistic goal, then the presence in modern warfare games of vehicles employed by actual militaries undoubtedly furthers that goal.”¹⁶⁹ Moreover, “assuming *arguendo* that realism is the *only* artistic interest that *Call of Duty* games possess—an assumption potentially belied by the presence of narrative campaign modes in all of the challenged games—it is also true that realism

161. *Id.*

162. *Id.*

163. *Id.*

164. *Id.* at 475–76.

165. *See, e.g., id.* at 476; *Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1136 (C.D. Cal. 2014) (noting that the plaintiff sued Activision over the use of an “angry monkey” mark in *Call of Duty: Ghosts*); *Novalogic, Inc. v. Activision Blizzard, Inc.*, 41 F. Supp. 3d 885, 888–89 (C.D. Cal. 2013) (noting that the plaintiff sued Activision over the use of the “Delta Force” word and design marks in *Call of Duty: Modern Warfare 3*).

166. *See AM General*, 450 F. Supp. 3d at 479–80, 489.

167. *Id.* at 477.

168. *Id.* at 479 (quoting *Novalogic*, 41 F. Supp. 3d at 890. The court also adopted the reasoning in another case that found Activision’s use of a trademark in *Call of Duty* “easily met the artistic relevance requirement” because it “gave players a ‘sense of a particularized reality of being part of an actual elite special forces operation and serve[d] as a means to increase specific realism of the game.’” *Id.* (citing *Novalogic*, 41 F. Supp. 3d at 900).

169. *Id.* at 484.

can have artistic merit in itself.”¹⁷⁰

To analyze the explicitly leading prong, the court applied the eight-factor analysis developed by the Second Circuit in *Polaroid Corp. v. Polarad Electronics Corp.* to determine whether a likelihood of confusion existed.¹⁷¹ The *Polaroid* factors are the strength of the plaintiff’s trademark, “the degree of similarity between the two marks,” the proximity of the products and their competition with one another, “the likelihood that the senior user will enter the junior user’s market in the future,” evidence of actual confusion, the “defendant’s good faith in adopting its own mark,” “the quality of the defendant’s product,” and the sophistication of consumers in the relevant market.¹⁷²

The court found the *Polaroid* factors weighed in Activision’s favor, with AM General showing only “the strength of its mark and a less than 20 percent risk of confusion.”¹⁷³ In analyzing the good faith *Polaroid* factor, the court focused on “the intent to sow confusion between the two companies’ products” and found that neither “the presence of Humvees decorated with *Call of Duty* logos at several in-person promotional events” nor a boilerplate statement regarding intellectual property ownership included on user guides inside the *Call of Duty* games that did not mention Humvees “demonstrate[d] a desire to ‘sow confusion between the two companies’ products.”¹⁷⁴

2. *Romantics v. Activision Publishing*

In the mid-2000s, Activision began publishing the *Guitar Hero* series of video games, one of which included *Guitar Hero Encore: Rocks the 80s*.¹⁷⁵ In *Rocks the 80s*, players “choose among options such as character, costume,

170. *Id.* at 484–85.

171. *Id.* at 480–84 (applying the analysis of *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492 (2d Cir. 1961). Notably, this likelihood of confusion analysis drawn from Second Circuit precedent departs from the Ninth Circuit’s approach, which does not analyze likelihood of confusion. *See supra* Part III.C.4.

172. *Am General*, 450 F. Supp. 3d at 480–81 (quoting *Polaroid*, 287 F.2d at 495).

173. *Id.* at 484.

174. *Id.* at 482–83 (quoting *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 388 (2d Cir. 2005)).

175. *See Press Release Details: Activision Set to Acquire Video Game Publisher RedOctane and Its Highly Popular Guitar Hero Franchise*, ACTIVISION, INC. (May 9, 2006), <https://investor.activision.com/news-releases/news-release-details/activision-set-acquire-video-game-publisher-redoctane-and-its>. RedOctane published the original *Guitar Hero* game in 2005, and Activision acquired RedOctane in 2006. *Id.*

and model of guitar.”¹⁷⁶ The game then allows “players to pretend they are playing guitar in a rock band” by simulating the “guitar play of various songs by correctly timing the pressing of fret buttons and strum bars on a guitar-like controller.”¹⁷⁷

Rocks the 80s contains “thirty songs from the 1980’s to add to the realistic experience of playing in a rock band from that era.”¹⁷⁸ One of the songs is “What I Like About You,” originally recorded by The Romantics in 1979 and published in 1980.¹⁷⁹ Activision obtained a valid, nonexclusive “synch license” from the owner of the copyright, which allowed Activision to “make a new recording of the underlying composition and to use that recording in synchronization with visual images in the video game to enable game play.”¹⁸⁰ As it appears in the game, the song is clearly identified by its title and the words, “as made famous by The Romantics.”¹⁸¹

The band and its members sued Activision, alleging false endorsement under the Lanham Act and a violation of their right of publicity.¹⁸² On the false endorsement claim, the Eastern District of Michigan granted summary judgment for Activision after analyzing the *Rogers* test and finding the First Amendment protected Activision’s use of the song in *Rocks the 80s*.¹⁸³

The court discussed the “artistic merits” of *Rocks the 80s* and found Activision’s use of the song in the game was related to its purpose of allowing players to pretend they are in a rock band.¹⁸⁴ Further, the court found the use did not explicitly mislead the public as to its source because the game and its promotional materials contained no “explicit indication” that The Romantics endorsed the game or had a role in producing it.¹⁸⁵ Consumers do not encounter the song until after they purchase and play the game (and even then, they might not ever encounter it), and the game describes the song “as made famous by The Romantics,” thus informing the player that The Romantics did

176. *Romantics v. Activision Publ’g, Inc.*, 574 F. Supp. 2d 758, 762 (E.D. Mich. 2008).

177. *Id.*

178. *Id.*

179. *Id.*

180. *Id.*

181. *Id.*

182. *Id.* at 761.

183. *Id.* at 766–71.

184. *Id.* at 766, 769.

185. *Id.* at 769 (citing *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d. Cir. 1989)).

not actually perform the version of the song that appears in the game.¹⁸⁶

3. *Dillinger v. Electronic Arts*

In 1969, Mario Puzo wrote the novel *The Godfather*, which Francis Ford Coppola later adapted into the *The Godfather* film trilogy.¹⁸⁷ In the late 2000s, EA developed and published two video games, *The Godfather* and *The Godfather II*, based on the films.¹⁸⁸ The first game “simulates the mafia world in New York during the mid-1900s,” where “[t]he player acts as a member of the Corleone family” and guides the character “through a variety of missions predicated on the plot of the original *Godfather* film.”¹⁸⁹ In the second game, the player guides the character “along the same plot-line as the movies,” but also “aims to control criminal networks in New York, Miami, and Cuba during the 1960s.”¹⁹⁰ Both games feature “period-appropriate vehicles and weapons,” including Thompson submachine guns, known as “Tommy Guns,” commonly associated with legendary criminal John Dillinger.¹⁹¹ In both games, a player “may choose and use a Tommy Gun identified as the Level Three ‘Dillinger Tommy Gun,’” one of fifteen firearms in the game.¹⁹² In the second game, a player can also purchase a “Modern Dillinger” and other weapons as part of a downloadable bundle.¹⁹³

Dillinger, LLC, which “claims to own the publicity rights” of John Dillinger and “the trademark rights in the words ‘John Dillinger,’” sued EA.¹⁹⁴ The Southern District of Indiana noted that the Seventh Circuit had not yet adopted the *Rogers* test, but since the parties agreed the *Rogers* test controlled EA’s First Amendment defense to Dillinger’s Lanham Act claims, the court “accept[ed] the parties’ position as to *Rogers* application, and assume[d] that *Rogers* control[led] without definitely deciding the question.”¹⁹⁵

186. *Id.*

187. Mario Puzo, *THE GODFATHER* (1969); *THE GODFATHER* (Paramount 1972); *THE GODFATHER PART II* (Paramount 1974); *THE GODFATHER PART III* (Paramount 1990); see *Dillinger, LLC v. Elec. Arts Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678, at *2 (S.D. Ind. June 16, 2011).

188. *Dillinger*, 2011 WL 2457678, at *2.

189. *Id.* at *3.

190. *Id.*

191. *Id.*

192. *Id.*

193. *Id.*

194. *Id.* at *1–2.

195. *Id.* at *4 n.1.

Turning to the question of artistic relevance, the court found that Tommy Guns were relevant to the virtual world depicted in the games, and the “Dillinger name is closely associated with the Tommy Gun.”¹⁹⁶ This connection was

enough to satisfy the *Rogers* test: The gentleman-bandit, commonly known for his public persona as a “flashy gangster who dressed well, womanized, drove around in fast cars, and sprayed Tommy Guns,” has above-zero relevance to a game whose premise enables players to act like members of the mafia and spray Tommy Guns.¹⁹⁷

The court then addressed whether EA’s use of the Dillinger name explicitly misleads as to the source and content of the games.¹⁹⁸ The court likely could have begun and ended its analysis with its finding that “plaintiff points to no *explicit* misrepresentation.”¹⁹⁹ But the court also found “no evidence that any consumer bought the *Godfather* Games because of the Dillinger name,” which was “‘incidental to the overall story of the game’ and ‘not the main selling point of the Game.’”²⁰⁰ And it found no evidence of any actual consumer confusion: “The Court cannot simply infer that the Dillinger name confuses the public, let alone that such confusion outweighs First Amendment concerns.”²⁰¹

IV. CASES BALANCING THE FIRST AMENDMENT’S PROTECTION OF VIDEO GAMES WITH THE RIGHT OF PUBLICITY

The above section discussed cases balancing the First Amendment with the Lanham Act, with every case finding that the First Amendment protects video games. By contrast, this section discusses cases balancing the First Amendment with the right of publicity, with many finding against First Amendment protection.

196. *Id.* at *4–6.

197. *Id.* at *5 (citation omitted).

198. *Id.* at *6–8.

199. *Id.* at *8.

200. *Id.* at *7 (quoting *E.S.S. Ent. 200, Inc. v. Rock Star Videos*, 547 F.3d 1095, 1100–01 (9th Cir. 2009)).

201. *Id.* at *7–8.

A. *The Right of Publicity*

The right of publicity refers to a person’s right “to control the commercial use of his or her identity” or likeness.²⁰² According to the Ninth Circuit, “[t]he theory of the right is that a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.”²⁰³

The right of publicity originated from the right to privacy.²⁰⁴ The famous article “The Right to Privacy” by Samuel Warren and Louis Brandeis in 1890,²⁰⁵ as well as early 20th century cases from New York and Georgia involving the unauthorized use of photographs in advertisements, set the stage for developing the right to privacy.²⁰⁶ But applying the privacy label to these cases became a stumbling block in cases where celebrities sued for the unauthorized use of their name or likeness.²⁰⁷ For example, in *O’Brien v. Pabst Sales Co.*, a football player sued the Pabst beer company for using his photograph on an advertising calendar.²⁰⁸ The majority rejected the football player’s “invasion of privacy” case, while the dissent focused upon the commercial value of the player’s identity.²⁰⁹

Twelve years after *O’Brien*, the Second Circuit became the first court to recognize a cause of action for violation of the right of publicity in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*²¹⁰ The court found that New

202. See 1 J. THOMAS MCCARTHY & ROGER E. SCHECHTER, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1.3 (2d ed. 2020) [hereinafter *THE RIGHTS OF PUBLICITY AND PRIVACY*] (“Today it is possible to state with clarity that the right of publicity is simply this: it is the inherent right of every human being to control the commercial use of his or her identity.”); *So Are Games Coffee Mugs or What?*, *supra* note 21, at 180 (“According to McCarthy and Schechter’s leading treatise on the subject, ‘The right of publicity is simply the inherent right of every human being to control the commercial use of his or her identity.’”).

203. *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1398 (quoting *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983)).

204. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 150 (3d Cir. 2013). For a more thorough history than discussed in this article, see *THE RIGHTS OF PUBLICITY AND PRIVACY*, *supra* note 202, §§ 1:27–1.36 (tracing development of right of publicity to the 21st century).

205. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

206. *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902); see also *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905).

207. See *THE RIGHTS OF PUBLICITY AND PRIVACY*, *supra* note 202, § 1:25.

208. 124 F.2d 167, 168 (5th Cir. 1941).

209. *Id.* at 168–71.

210. 202 F.2d 866, 868 (2d Cir. 1953).

York's common law protected a baseball player's right in the publicity value of his photograph, and it coined "right of publicity" as the name of this right.²¹¹ Law review articles by Melville Nimmer and William Prosser would further define and set the groundwork for the right to privacy and the right of publicity.²¹²

No federal right of publicity exists as of today; instead, thirty-three states recognize the right by statute, common law, or both, with varying formulations.²¹³ As one example, California provides both a common law and a statutory right of publicity. A plaintiff alleging a right of publicity claim under California common law must establish "(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury."²¹⁴ Similarly, California's right of publicity statute provides:

Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchase of, products, merchandise, goods or services, without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.²¹⁵

The U.S. Supreme Court addressed the right of publicity for the only time more than forty years ago in *Zacchini v. Scripps-Howard Broadcasting Co.*²¹⁶ There, a performer in a "human cannonball" act sued a television broadcasting company for broadcasting his entire 15-second performance without his permission.²¹⁷ The Court found "the [s]tate's interest in permitting a 'right of

211. *Id.*

212. See generally Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954); William Prosser, *Privacy*, 48 CALIF. L. REV. 383 (1960).

213. See THE RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 202, §§ 6.2, 6.6. Attempts to enact a federal right of publicity statute have failed. See Barbara A. Solomon, *Can the Lanham Act Protect Tiger Woods? An Analysis of Whether the Lanham Act is a Proper Substitute for a Federal Right of Publicity*, 94 TRADEMARK REP. 1202, 1210–11 (2004).

214. *Local TV, LLC v. Superior Court*, 206 Cal. Rptr. 3d 884, 889–90 (Cal. Ct. App. 2016) (quoting *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 346 (Cal. Ct. App. 1983)).

215. Cal. Civ. Code § 3344 (West 2020).

216. 433 U.S. 562, 563 (1977).

217. *Id.* at 563–64.

publicity’ is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment,²¹⁸ and held the First Amendment did not protect the broadcast of Zacchini’s entire performance because doing so “poses a substantial threat to the economic value of that performance.”²¹⁹ In so holding, however, the Court contrasted “the broadcast of petitioner’s entire performance” with “the unauthorized use of another’s name for purposes of trade or the incidental use of a name or picture by the press,” finding the former “goes to the heart of petitioner’s ability to earn a living as an entertainer.”²²⁰ The court found the “strongest case for a ‘right of publicity’” involves “not the appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.”²²¹ Thus, *Zacchini* offered little guidance in cases involving depictions of individuals.

B. Development of the Transformative Use Test in Right of Publicity Cases

Following *Zacchini*, lower courts developed different tests to balance the First Amendment with the right of publicity.²²² Some apply a form of the *Rogers* test to determine whether the use of a name or likeness is “wholly unrelated” to an expressive work or “simply a disguised commercial advertisement for the sale of goods or services.”²²³ Others apply the transformative use test, which has become the dominant test used in right of publicity cases.²²⁴ California was the first to adopt the transformative use test, so this article begins there.

218. *Id.* at 573.

219. *Id.* at 575.

220. *Id.* at 576.

221. *Id.*

222. *See Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 514 (7th Cir. 2014) (“The Supreme Court has not addressed the question, and decisions from the lower courts are a conflicting mix of balancing tests and frameworks borrowed from other areas of free-speech doctrine.”).

223. *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) (first quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 457 n.6 (Cal. 1979); then quoting *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828, 829 (N.Y. App. Div. 1980)).

224. *See infra* Sections IV.B.2–3, IV.C, IV.D.1–5.

1. *Guglielmi v. Spelling-Goldberg Productions*

In 1979, the California Supreme Court decided its seminal right of publicity case in *Guglielmi v. Spelling-Goldberg Productions*.²²⁵ There, the successor in interest of actor Rudolph Valentino sued the creators of a biographical film that told a fictionalized version of Valentino's life story.²²⁶ Chief Justice Bird's concurrence stated that the First Amendment provided a complete defense against the plaintiff's right of publicity claim.²²⁷ Chief Justice Bird observed that "[c]ontemporary events, symbols and people are regularly used in fictional works," and "[f]iction writers may be able to more persuasively, more accurately express themselves by weaving into the tale persons or events familiar to their readers."²²⁸ She explained that "[n]o author should be forced into creating mythological worlds or characters wholly divorced from reality" to avoid facing a right of publicity claim.²²⁹

The Chief Justice then stated that "an action for infringement of the right of publicity can be maintained only if the proprietary interests at issue clearly outweigh the value of free expression."²³⁰ She applied that balancing inquiry and found that

[w]hether the publication involved was factual and biographical or fictional, the right of publicity has not been held to outweigh the value of free expression. Any other conclusion would allow reports and commentaries on the thoughts and conduct of public and prominent persons to be subject to censorship under the guise of preventing the dissipation of the publicity value of a person's identity.²³¹

Thus, the First Amendment protected the use of Valentino's name and likeness in the film.²³²

225. *Guglielmi*, 603 P.2d at 455.

226. *Id.*

227. *Id.* at 457–62 (Bird, C.J., concurring).

228. *Id.* at 460 (Bird, C.J., concurring).

229. *Id.*

230. *Id.* at 461 (Bird, C.J., concurring).

231. *Id.* at 461–62 (Bird, C.J., concurring).

232. *Id.* at 462 (Bird, C.J., concurring). The court also found the First Amendment protected the use of Valentino's name and likeness in advertisements for the film: "It would be illogical to allow respondents to exhibit the film but effectively preclude any advance discussion or promotion of their lawful enterprise." *Id.*

For many years after *Guglielmi*, California courts applied a robust First Amendment protection against right of publicity claims in the film context without applying a transformative use test.²³³ For example, in *Dora v. Frontline Video, Inc.*, the court of appeal held the First Amendment protected a producer of a documentary about surfers in Malibu from a surfer's claims for violation of his right of publicity.²³⁴ And in *Polydoros v. Twentieth Century Fox Film Corp.*, the court of appeal held the First Amendment protected a writer and director of a fictional film that included a character resembling the plaintiff as a child.²³⁵ The court noted that to succeed on his claims, the plaintiff "must establish a direct connection between the use of his name or likeness and a *commercial* purpose," and the mere creation of an expressive work for financial gain did not satisfy that requirement.²³⁶

2. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*

In 2001, the California Supreme Court adopted the transformative use test to a right of publicity claim.²³⁷ In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, the owner of the intellectual property rights in The Three Stooges sued an artist who had made a charcoal drawing of The Three Stooges and sold it as a lithograph and on t-shirts.²³⁸ The court found the artist had used the likenesses on "products, merchandise, or goods"—lithographs and t-shirts—within the meaning of the California right of publicity statute.²³⁹ It then found the case before it did "not concern commercial speech" because the artist's portraits were "expressive works and not an advertisement for or endorsement of a product."²⁴⁰ The First Amendment applied even though the artist created the works for profit and for entertaining, and even though the art appeared on "a less conventional avenue of communications."²⁴¹

The court did not stop at recognizing the "high degree of First Amendment protection for noncommercial speech about celebrities,"

233. See *Dora v. Frontline Video, Inc.*, 18 Cal. Rptr. 2d 790 (Cal. Ct. App. 1993); *Polydoros v. Twentieth Cent. Fox Film Corp.*, 79 Cal. Rptr. 2d 207 (Cal. Ct. App. 1997).

234. *Dora*, 18 Cal. Rptr. 2d at 791, 794.

235. *Polydoros*, 79 Cal. Rptr. 2d at 208.

236. *Id.* at 209–10.

237. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

238. *Id.* at 800–01.

239. *Id.* at 802.

240. *Id.*

241. *Id.* at 802, 804.

however, because not “all expression that trenches on the right of publicity receives such protection.”²⁴² Instead, it analogized the right of publicity to copyright law and found the state “legislature ha[d] a rational basis for permitting celebrities and their heirs to control the commercial exploitation of the celebrity’s likeness.”²⁴³ Thus, it searched for a test to “distinguish between protected and unprotected expression.”²⁴⁴

The court reviewed copyright law’s fair use doctrine and found that a “wholesale importation” of it “into right of publicity law would not be advisable” because several fair use factors are not “useful for determining whether the depiction of a celebrity likeness is protected by the First Amendment.”²⁴⁵ But the court nevertheless took the first factor, “the purpose and character of the use,” finding it “particularly pertinent to the task of reconciling the rights of free expression and publicity.”²⁴⁶ The court reasoned that

[w]hen artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.²⁴⁷

But “when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.”²⁴⁸

Thus, the court adopted the transformative use test:

[W]hen an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive

242. *Id.* at 804.

243. *Id.* at 805. Thus, it appears the California Supreme Court applied a rational basis test rather than a strict scrutiny test to the right of publicity. *Id.*

244. *Id.* at 807.

245. *Id.* at 807–08.

246. *Id.* at 808.

247. *Id.*

248. *Id.*

primarily from the celebrity's fame.²⁴⁹

The court then offered several factors to consider in applying the test: (1) "whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question";²⁵⁰ (2) whether the work is "primarily the defendant's own expression" that is "something other than the likeness of the celebrity";²⁵¹ (3) "whether the literal and imitative or the creative elements predominate in the work";²⁵² (4) whether "the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted," or "from the creativity, skill, and reputation of the artist";²⁵³ and (5) whether the "artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame."²⁵⁴

Applying the transformative use test, the court found it could "discern no significant transformative or creative contribution" by the artist, that the artist's "undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame," and that "the marketability and economic value of [the artist's] work derive[s] primarily from the fame of the celebrities depicted."²⁵⁵ Thus, the work failed the transformative use test.²⁵⁶

3. *Winter v. DC Comics*

Two years after *Comedy III*, the California Supreme Court applied the transformative use test to comic books in *Winter v. DC Comics*.²⁵⁷ DC Comics had published a "five-volume comic miniseries featuring 'Jonah Hex,' a

249. *Id.* at 810.

250. *Id.* at 809.

251. *Id.*

252. *Id.*

253. *Id.* at 810.

254. *Id.* The Ninth Circuit in *Keller* viewed *Comedy III* as establishing these five factors. See *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig)*, 724 F.3d 1268, 1274 (9th Cir. 2013) [hereinafter *Keller*].

255. *Comedy III*, 21 P.3d at 810–11.

256. *Id.* at 811.

257. *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).

fictional comic book ‘anti-hero.’”²⁵⁸ “The series contains an outlandish plot, involving giant worm-like creatures, singing cowboys, and the ‘Wilde West Ranch and Music and Culture Emporium’”²⁵⁹ Three volumes referenced or featured the half-worm, half-human brothers Johnny and Edgar Autumn.²⁶⁰

Musicians Johnny and Edgar Winter sued for violation of their right of publicity.²⁶¹ The court applied the transformative use test it had adopted in *Comedy III* and found (1) the comic books “are not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs’ mere likenesses,” (2) plaintiffs are not depicted literally, but are “merely part of the raw materials from which the comic books were synthesized,” (3) any resemblance of plaintiffs is “distorted for purposes of lampoon, parody, or caricature,” (4) “the Autumn brothers are but cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive,” and (5) the Winters’ “fans who want to purchase pictures of them would find the drawings of the Autumn brothers unsatisfactory as a substitute for conventional depictions.”²⁶² Thus, the court concluded, the comic books were “transformative and entitled to First Amendment protection.”²⁶³

The court distinguished its earlier decision in *Comedy III*:

The artist in [*Comedy III*] essentially sold, and devoted fans bought, pictures of The Three Stooges, not transformed expressive works by the artist. Here, by contrast, defendants essentially sold, and the buyers purchased, DC Comics depicting fanciful, creative characters, not pictures of the Winter brothers. This makes all the difference.²⁶⁴

258. *Id.* at 476.

259. *Id.*

260. *Id.*

261. *Id.*

262. *Id.* at 479.

263. *Id.* at 480. The court further found that whether DC Comics was “trading on plaintiffs’ likenesses and reputations to generate interest” in the comic books was irrelevant, since “[t]he question [was] whether the work is transformative, not how it is marketed.” *Id.* at 479.

264. *Id.* at 480. As Professor Ford explains, the court’s analysis and conclusion allow one to read *Winter* as requiring “significant visual changes to a real person in order to qualify as transformative, which makes it risky to provide realistic portrayals of real people in comic books.” *So Are Games Coffee Mugs or What?*, *supra* note 21, at 186.

C. *California State Cases Applying the Transformative Use Test to Video Games*

1. *Kirby v. Sega of America, Inc.*

Not only was California the first jurisdiction to adopt the transformative use test in right of publicity cases, it was also the first to apply the test in the video game context when the California Court of Appeal decided *Kirby v. Sega of America, Inc.*²⁶⁵ Kierin Kirby, “the lead singer of a retro-funk-dance musical group known as ‘Deee-Lite’ which was popular in the early 1990’s,” claimed Sega used her likeness as the basis for the character Ulala in *Space Channel 5*, a video game first released in Japan in 1999.²⁶⁶ *Space Channel 5* is “set in outer space in the 25th century” and features Ulala, “who works for a news channel called Space Channel 5.”²⁶⁷ “In the game, Ulala is dispatched to investigate an invasion of Earth by dance-loving aliens who shoot earthlings with ray guns, causing them to dance uncontrollably.”²⁶⁸ She “encounters the aliens and competitor reporters” during her investigation and must “match the dance moves of the other characters.”²⁶⁹

After recognizing that “[v]ideo games are expressive works entitled to as much First Amendment protection as the most profound literature,” the court of appeal applied the transformative use test to Kirby’s right of publicity claim.²⁷⁰ The court described the “inquiry [as] whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”²⁷¹

The court of appeal first noted similarities between Ulala and Kirby’s appearances: they were both “thin” with “similarly shaped eyes and faces, red lips and red or pink hair,” and both wore “brightly-colored, form-fitting clothing, including short skirts and platform shoes in a 1960’s retro style.”²⁷²

265. See 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006).

266. *Id.* at 609.

267. *Id.* at 610.

268. *Id.*

269. *Id.*

270. *Id.* at 615–16.

271. *Id.* at 615 (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001)).

272. *Id.* at 613.

Moreover, “Ulala’s name is a phonetic variant of ‘ooh la la,’ a phrase often used by Kirby and associated with Kirby,” and Ulala and Kirby both use some of the same words and phrases, such as “groove,” “meow,” “dee-lish,” and “I won’t give up.”²⁷³

But the court also found significant differences between the two.²⁷⁴ Their physiques were different, and Ulala’s appearance was based on the Japanese anime style.²⁷⁵ Ulala’s hairstyle and clothing also “differ[ed] from those worn by Kirby.”²⁷⁶ Further, *Space Channel 5* is set in 25th century outer space, while “Kirby’s fashion approach harkens back to a retro 1960’s style, and neither her videos nor photographs relate to outer space.”²⁷⁷ Finally, a Japanese choreographer and dancer had created Ulala’s dance moves, which were different than Kirby’s.²⁷⁸

The court concluded that “notwithstanding certain similarities, Ulala is more than a mere likeness or literal depiction of Kirby.”²⁷⁹ The differences between Ulala and Kirby “demonstrate Ulala is ‘transformative,’” and Sega “added creative elements to create a new expression.”²⁸⁰ Thus, “Ulala contains sufficient expressive content to constitute a ‘transformative work’ under the test articulated by the [California] Supreme Court,” and the First Amendment protected the game from Kirby’s right of publicity claim.²⁸¹

2. *No Doubt v. Activision Publishing, Inc.*

Five years after *Kirby*, a different division of the California Court of Appeal²⁸² reached the opposite result in another video game case, *No Doubt v. Activision Publishing, Inc.*, in which the rock band No Doubt sued Activision over the use of the bandmembers’ likenesses in *Band Hero*.²⁸³

273. *Id.*

274. *Id.* at 613, 616.

275. *Id.*

276. *Id.* at 616.

277. *Id.* at 613.

278. *Id.* at 609.

279. *Id.* at 616.

280. *Id.*

281. *Id.*

282. “The California Courts of Appeal are divided into six appellate districts,” some of which “are further divided into Divisions.” *California Courts of Appeal*, CALIFORNIA COURTS, <https://www.courts.ca.gov/courtsofappeal.htm> (last visited Oct. 7, 2020).

283. 122 Cal. Rptr. 3d 397, 400 (Cal. Ct. App. 2011). More specifically, No Doubt had “licensed

Band Hero is a “version of Activision’s *Guitar Hero* franchise” that “allows players to simulate performing in a rock band in time with popular songs.”²⁸⁴ *Band Hero* contains more than sixty popular songs and also “permits players to create their own music.”²⁸⁵ Players perform the songs by using avatars to represent them, which they can design themselves or choose from among ones already available, including “fictional characters created and designed by Activision” as well as “digital representations of real-life rock stars.”²⁸⁶

The court held that Activision’s use of No Doubt’s likenesses in *Band Hero* was not transformative.²⁸⁷ It found Activision used “literal reproductions” of the likenesses “so that players could choose to ‘be’ the No Doubt rock stars,” and that *Band Hero* did not allow players “to alter the No Doubt avatars”; instead, “they remain at all times immutable images of the real celebrity musicians.”²⁸⁸ Although the court recognized that “even literal reproductions of celebrities can be ‘transformed’ into expressive works based on the context into which the celebrity image is placed,”²⁸⁹ it found the “context in which Activision uses the literal likenesses of No Doubt’s members does not qualify the use of the likenesses for First Amendment protection.”²⁹⁰

The court found that, unlike Sega’s portrayal of Ulala in *Space Channel 5* as a news reporter in the 25th century, the No Doubt avatars in *Band Hero* “perform rock songs, the same activity by which the band achieved and maintains its fame,” and they did so “as literal recreations of the band members.”²⁹¹ The court rejected Activision’s argument that its use of the likenesses was transformative because the avatars could perform at “fanciful venues including outer space,” perform songs “the real band would object to singing,” and that the likenesses appear “in the context of a videogame that contains many other creative elements.”²⁹² In short, the court zeroed in on its

the likenesses of its members for use in *Band Hero*,” but alleged “that Activision used [their likenesses] in objectionable ways outside the scope of the parties’ licensing agreement.” *Id.*

284. *Id.* at 401. *Romantics v. Activision Publishing, Inc.* discussed the *Guitar Hero* games. 574 F. Supp. 2d. 758 (E.D. Mich. 2008).

285. *No Doubt*, 122 Cal. Rptr. 3d at 401.

286. *Id.*

287. *Id.* at 410–12, 415.

288. *Id.* at 409–10.

289. *Id.* at 410 (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001)).

290. *Id.*

291. *Id.* at 411.

292. *Id.*

finding that the avatars were “exact depictions of No Doubt’s members doing exactly what they do as celebrities.”²⁹³

Moreover, the court found that Activision’s use of No Doubt’s likenesses was “motivated by the commercial interest in using the band’s fame to market *Band Hero*, because it encourages the band’s sizeable fan base to purchase the game so as to perform as, or alongside, the members of No Doubt.”²⁹⁴ According to the court, “insofar as the depiction of No Doubt is concerned, the graphics and other background content of the game are secondary, and the expressive elements of the game remain ‘manifestly subordinated to the overall goal of creating a conventional portrait of [No Doubt] so as to commercially exploit [its] fame.’”²⁹⁵ “In other words, nothing in the creative elements of the *Band Hero* elevates the depictions of No Doubt to something more than ‘conventional, more or less fungible, images’ of its members that No Doubt should have the right to control and exploit.”²⁹⁶

3. *Washington v. Take-Two Interactive Software, Inc.*

This article previously discussed ESS’s lawsuit over Rockstar’s depiction of a strip club in *Grand Theft Auto: San Andreas*.²⁹⁷ In *Washington v. Take-Two Interactive Software, Inc.*, Michael Washington, a “professional model” and “back-up singer . . . in the . . . rap group ‘Cypress Hill,’” sued Rockstar “alleging that [it] misappropriated his likeness and identity for the [main] character” in *San Andreas*, Carl Johnson (CJ).²⁹⁸

The court of appeal began by describing *San Andreas* as “essentially an animated, interactive movie.”²⁹⁹ Applying the transformative use test, the court found that CJ was “‘not a literal depiction’ of Washington,”³⁰⁰ since CJ’s

293. *Id.*

294. *Id.*

295. *Id.* (alterations in original) (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001)).

296. *Id.* (quoting *Comedy III*, 21 P.3d at 808). In *Romantics*, the Eastern District of Michigan applied the *Rogers* test to another band’s right of publicity claim in a case involving the use of a song in Activision’s *Guitar Hero Encore: Rocks the 80s*—a game very similar to *Band Hero*—and found the First Amendment protected the game. See *Romantics v. Activision Publ’g Inc.*, 574 F. Supp. 2d 758, 765–766 (E.D. Mich. 2008).

297. *E.S.S. Entm’t 2000 Inc., v. Rock Star Videos*, 547 F.3d 1095 (9th Cir. 2008); see *supra* notes 76–96 and accompanying text (discussing the case).

298. No. B232929, 2012 WL 5358709, at *2 (Cal. Ct. App. Oct. 31, 2012).

299. *Id.* at *1.

300. *Id.* at *11 (quoting *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 616 (Cal. Ct. App. 2006)).

“appearance is rather ‘generic’” and “there is not a single feature that ‘directly links’ CJ to Washington, such as ‘distinctive tattoos, birthmarks or other physical features.’”³⁰¹ Further, CJ’s “physical appearance changes during the game depending on the amount he exercises and the amount he eats,” and nothing suggests that “CJ’s clothing or accessories, which also change throughout the game, are based on Washington’s appearance.”³⁰²

Further, the court found *San Andreas* had “significant creative elements that have no apparent connection to Washington.”³⁰³ The game takes place in different cities, where “CJ encounters dozens (if not hundreds) of characters, including police officers, drug dealers, gang members and members of his own family.”³⁰⁴ Throughout the game, CJ also “confront[s] many social issues, including police corruption, race relations, drug dealing, and gang culture.”³⁰⁵ And none of the locations, characters, or events in *San Andreas* were based on Washington’s life.³⁰⁶ The court also held that even if Rockstar had used Washington’s likeness, “CJ is a ‘fanciful, creative character’ who exists in the context of a unique and expressive video game,” like Ulala was in *Kirby*, and therefore any use would not have been the “very sum and substance” of *San Andreas*, but just “one of the ‘raw materials’ from which [the game] is synthesized.”³⁰⁷

Finally, the court of appeal distinguished the case before it from *No Doubt*, finding that Washington had “presented no evidence demonstrating that the plot or characters” of *San Andreas* had “any relevance to his life or his purported fame,”³⁰⁸ whereas in *No Doubt*, the court had found the avatars were “exact depictions of No Doubt’s members doing exactly what they do as celebrities.”³⁰⁹

301. *Id.*

302. *Id.*

303. *Id.*

304. *Id.*

305. *Id.*

306. *Id.*

307. *Id.* (first quoting *Kirby*. *Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 618 (Cal. Ct. App. 2006); then quoting *Winter v. DC Comics*, 69 P.3d 473, 477 (Cal. 2003)).

308. *Id.* at *12.

309. *Id.* (quoting *No Doubt v. Activision Publ’g Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011)).

4. *Noriega v. Activision/Blizzard*

This article previously discussed AM General’s lawsuit over Activision’s use of Humvees in the *Call of Duty* series, and mentioned two other district court cases in which plaintiffs sued for trademark infringement over *Call of Duty*.³¹⁰ In 2014, Manuel Noriega sued Activision over the use of his likeness in *Call of Duty: Black Ops II*.³¹¹ Noriega was a former general in the Panamanian army and former dictator of Panama, who “controlled all elements of the Panamanian government” and was involved in drug trafficking, money laundering, and arms dealing.³¹² A series of escalations between Panama and the United States led to Operation Just Cause—the U.S. invasion of Panama—in 1989.³¹³ Noriega was later convicted in the United States, Panama, and France of various offenses, and he died in 2017.³¹⁴

The superior court dismissed Noriega’s right of publicity claim, focusing on several facts.³¹⁵ In *Black Ops II*, players “assume the role of a foot soldier placed in simulated infantry and warfare scenarios.”³¹⁶ “[T]he game is set in the context of the Cold War and incorporates clandestine CIA operations driven by specialized Black Ops soldiers”³¹⁷ The Noriega character in *Black Ops II* appeared in only two of the eleven missions for “a matter of minutes and voice[d] less than 30 lines” and was just “one of more than 45 characters, including other historical figures.”³¹⁸ Moreover, players “can never assume the Noriega character’s identity, control its movements or experience gameplay through its eyes.”³¹⁹ Activision “devoted two years, over \$100 million and a team of over 250 designers, engineers and talent to

310. *See supra* notes 156–174 and accompanying text.

311. *Noriega v. Activision/Blizzard, Inc.*, No. BC 551747, 2014 WL 5930149, at *1 (Cal. Super. Ct. Oct. 27, 2014). The caption in the order misspells Noriega’s name as Noreiga, but the register of actions reflects the correct spelling of his name. *See id.*

312. *Id.* at *3.

313. *See id.*

314. *See id.*; *see also* Randal C. Archibold, *Manuel Noriega, Dictator Ousted by U.S. in Panama, Dies at 83*, N.Y. TIMES (May 30, 2017), <https://www.nytimes.com/2017/05/30/world/americas/manuel-antonio-noriega-dead-panama.html>.

315. *Noriega*, 2014 WL 5930149, at *3; *see also infra* notes 316–322 and accompanying text (discussing the facts the court focused on).

316. *Noriega*, 2014 WL 5930149, at *3.

317. *Id.*

318. *Id.*

319. *Id.*

develop and produce” the game,³²⁰ and it did not use the Noriega character “in any marketing or advertising of the game.”³²¹

The court found that

this evidence compels the conclusion that [Activision’s] use of Noriega’s likeness was transformative. The publicly available photographs of Noriega used to create his avatar were part of the extensive “raw materials” from which the game was synthesized. Noriega’s depiction was not the “very sum and substance” of the work. The complex and multi-faceted game is a product of defendants’ own expression, with *de minimis* use of Noriega’s likeness. . . . [T]he marketability and economic value of the [game] . . . comes not from Noriega, but from the creativity, skill and reputation of [Activision].³²²

5. A Non-Video Game Case for Comparison: *de Havilland v. FX Networks, LLC*

In *de Havilland v. FX Networks, LLC*, actress Olivia de Havilland alleged the creators and producers of *Feud: Bette and Joan* violated her right of publicity.³²³ *Feud* is a “docudrama about film stars Bette Davis and Joan Crawford,” in which Catherine Zeta-Jones portrays de Havilland, “a close friend of Davis.”³²⁴

The court of appeal first concluded that the First Amendment protected FX’s use of de Havilland’s likeness in *Feud* even without applying the transformative use test.³²⁵ Citing *Sarver v. Chartier*, the court found *Feud* “is speech that is fully protected by the First Amendment, which safeguards the storytellers and artists who take the raw materials of life—including the stories of real individuals, ordinary or extraordinary—and transform them into

320. *Id.*

321. *Id.*

322. *Id.* at *4. As Professor Ford has explained, the *Noriega* court’s focus on the game as a whole is consistent with *Comedy III*, but inconsistent with *No Doubt*. See *So Are Games Coffee Mugs or What?*, *supra* note 21, at 197–98. But *Noriega* apparently did not appeal the superior court’s decision, so the court of appeal lacked the opportunity to address the inconsistency between the trial court’s decision and *No Doubt*.

323. 230 Cal. Rptr. 3d 625, 630 (Cal. Ct. App. 2018), *cert. denied*, 139 S. Ct. 800 (2019).

324. *Id.* at 630–31.

325. See *id.* at 638.

art, be it articles, books, movies, or plays.”³²⁶ The court provided several examples where creators of expressive works could portray real people without acquiring their rights:

The creators of *The People v. O.J. Simpson: American Crime Story* can portray Trial Judge Lance Ito without acquiring his rights. *Fruitvale Station*’s writer and director Ryan Coogler can portray Bay Area Rapid Transit officer Johannes Mehserle without acquiring his rights. HBO can portray Sarah Palin in *Game Change* (HBO 2013) without acquiring her rights.³²⁷

Turning to the transformative use test, the court first questioned its applicability to films: “*Comedy III*’s ‘transformative’ test makes sense when applied to products and merchandise—‘tangible personal property,’ in the Supreme Court’s words. Lower courts have struggled mightily, however, to figure out how to apply it to expressive works such as films, plays, and television programs.”³²⁸ Nevertheless, the court applied the test and disagreed with the trial court’s finding that there was “nothing transformative about the docudrama” simply because FX “wanted to make the appearance of [de Havilland] as real as possible.”³²⁹

The court of appeal pointed out several factors that made the use transformative. First, “[t]he de Havilland role . . . constitutes about 4.2 percent of *Feud*,” a miniseries that focuses on the competition between Bette Davis and Joan Crawford but also tells many other stories.³³⁰ Second, FX used de Havilland’s likeness as “one of the ‘raw materials’ from which [the] original work [*Feud*] [was] synthesized,” and “*Feud*’s ‘marketability and economic value’ [did] not ‘derive primarily from [de Havilland’s] fame’ but rather ‘[came] principally from . . . the creativity, skill, and reputation’ of *Feud*’s

326. *Id.* (quoting *Sarver v. Chartier*, 813 F.3d 891, 905 (9th Cir. 2016)).

327. *Id.* at 639. Likewise, “[y]ou are entitled to write (and sell) your own unauthorized biography of Arnold Schwarzenegger, whether or not there’s already an authorized biography that adequately covers the territory.” Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 923 (2003); *cf. Restoring Rogers*, *supra* note 21, at 312 (discussing the use of trademarks in films).

328. *de Havilland*, 230 Cal. Rptr. 3d at 641 (citation omitted) (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001)).

329. *Id.* (alteration in original).

330. *Id.*

creators and actors.”³³¹ In short, the court found, “*Feud* constitutes ‘significant expression’—a story of two Hollywood legends—of which the de Havilland character is but a small part.”³³²

D. Federal Cases Applying the Transformative Use Test to Video Games

Several federal cases have applied the transformative use test to right of publicity claims in video games. Three discussed below involve the use of likenesses in realistic sports games and have shifted the law greatly towards protecting the right of publicity at the cost of the First Amendment. The other two found the use of an individual’s likeness sufficiently transformed, but only in games where realism was not a goal.

1. *Hart v. Electronic Arts*

In EA’s *NCAA Football*, players can choose a “basic single-game format” where two college football teams play against each other, or other game modes such as the “Dynasty Mode” that “allows [players] to ‘control[] a college program for up to thirty seasons,’ including ‘year-round responsibilities of a college coach’”; or the “Race for the Heisman” (or “Campus Legend”) mode that allows players to control a virtual high school football player “through his collegiate career, making his or her own choices regarding practices, academics and social activities.”³³³

NCAA Football owed its success to “its focus on realism and detail—from realistic sounds, to game mechanics, to team mascots.”³³⁴ As part of that realism, the game has “‘over 100 virtual teams’ . . . populated by digital avatars that resemble their real-life counterparts and share their vital and biographical information.”³³⁵ Players can change an avatar’s appearance and vital statistics, but other details remain unchangeable.³³⁶ “Thus, for example, in *NCAA Football 2006*, Rutgers’ quarterback, player number 13, is 6’2” tall, weighs 197 pounds and resembles [Ryan] Hart,” a quarterback, player number

331. *Id.* (first, second, fifth, and seventh alterations in original) (quoting *Comedy III*, 21 P.3d at 810).

332. *Id.*

333. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 146 (3d Cir. 2013) (second alteration in original).

334. *Id.*

335. *Id.*

336. *Id.*

13, who played for Rutgers “for the 2002 through 2005 seasons.”³³⁷ And Hart sued EA for using his likeness and biographical information in *NCAA Football* under New Jersey’s right of publicity law.³³⁸

The Third Circuit surveyed the different tests that courts used over the years to balance First Amendment protections with right of publicity claims.³³⁹ It analyzed whether to apply “the commercial-interest-based Predominant Use Test, the trademark-based *Rogers* Test, [or] the copyright-based Transformative Use Test.”³⁴⁰ In a lengthy analysis, the court declined to adopt either of the first two and instead opted to apply the transformative use test.³⁴¹

Applying the transformative use test, the court focused on “whether [Hart’s] identity is sufficiently transformed in *NCAA Football*.”³⁴² First, it found the “digital avatar’s appearance and the biographical and identifying information” closely resembled Hart.³⁴³ Second, the court found the avatar “does what the actual Ryan Hart did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of a college football game.”³⁴⁴ The court found these elements were not transformative because they did not change Hart’s “identity in a significant way.”³⁴⁵ Third, the court found the players’ ability to alter the avatar’s appearance insufficient to meet the transformative use test because EA’s goal in *NCAA Football* was to “create a realistic depiction of college football,” part of which “involves generating realistic representations of the various college teams—which includes the realistic representations of the players.”³⁴⁶ Because realism is “central to the core of the game experience,” the ability for players to change the avatar’s appearance was not enough to transform Hart’s likeness.³⁴⁷ Finally, the court rejected EA’s argument that other creative elements of *NCAA Football* should be considered, and limited

337. *Id.* at 146, 145.

338. *Id.* at 145.

339. *See id.* at 152–65.

340. *Id.* at 153.

341. *Id.* at 153–65.

342. *Id.* at 165.

343. *Id.* at 166.

344. *Id.*

345. *Id.*

346. *Id.* at 168.

347. *Id.*

its analysis only to elements of the game that “in some way[] affect the use or meaning of [Hart’s] identity.”³⁴⁸

Judge Ambro dissented.³⁴⁹ He made two key points. First, he found the majority unduly limited “their transformative inquiry to Hart’s identity alone, disregarding other features of the work.”³⁵⁰ Rather, in applying the transformative use test, “it is necessary to review the likeness in the context of the work in its entirety, rather than focusing only on the individual’s likeness.”³⁵¹

Second, Judge Ambro found the majority had “penalize[d] EA for the realism and financial success of *NCAA Football*,” and that decision cannot be reconciled with “First Amendment protections traditionally afforded to true-to-life depictions of real figures and works produced for profit.”³⁵² The First Amendment protects “biographies, documentaries, docudramas, and other expressive works depicting real-life figures, whether the accounts are factual or fictional.”³⁵³ Moreover, the sale of expressive works for profit does not diminish First Amendment protections, which apply equally to video games as to other expressive works.³⁵⁴

Thus, EA’s use of real-life likenesses as “characters” in its *NCAA Football* video game should be as protected as portrayals (fictional or nonfictional) of individuals in movies and books. . . . And . . . [any] profit flow[ing] from EA’s realistic depiction of Hart (and the myriad other college football players portrayed in *NCAA Football*) is not constitutionally significant, nor even an appropriate consideration.³⁵⁵

Applying his understanding of the transformative use test, Judge Ambro concluded that “EA’s use of avatars resembling actual players is entitled to First Amendment protection.”³⁵⁶ He referenced the “original graphics, videos, sound effects, and game scenarios” in the game; players’ ability “to direct the

348. *Id.* at 169.

349. *Id.* at 170 (Ambro, J., dissenting).

350. *Id.*

351. *Id.*

352. *Id.*

353. *Id.* at 173 (Ambro, J., dissenting).

354. *Id.* at 173–74 (Ambro, J., dissenting).

355. *Id.* at 174 (Ambro, J., dissenting).

356. *Id.*

play of a college football team whose players may be based on a current roster, a past roster, or an entirely imaginary roster comprised of made-up players”; that players “are not reenacting real games, but rather are directing the avatars in invented games and seasons”; and that players can “control virtual players and teams for multiple seasons, creating the means by which they can generate their own narratives.”³⁵⁷

2. *In re NCAA Student-Athlete Name & Likeness Licensing Litigation (Keller)*

At the same time the Third Circuit considered *Hart*, the Ninth Circuit faced a materially identical case in *Keller*, where several college football players (including Samuel Keller) sued EA for using their likenesses in *NCAA Football*.³⁵⁸ Like the Third Circuit, the Ninth Circuit rejected the *Rogers* test in favor of the transformative use test.³⁵⁹ It identified five factors from the California Supreme Court’s decision in *Comedy III* to analyze in determining whether the use of a likeness is sufficiently transformative.³⁶⁰ Ultimately, the court’s analysis mirrored that of the Third Circuit’s in *Hart*, and it reached the same conclusion—that EA’s use of college football players’ likenesses in *NCAA Football* was not transformative because “*NCAA Football* realistically portrays college football players in the context of college football games.”³⁶¹

In yet another similarity, Judge Thomas dissented in *Keller* just as Judge Ambro dissented in *Hart*.³⁶² Judge Thomas found the First Amendment protected *NCAA Football* “because the creative and transformative elements” of the game “predominate over the commercial use of the athletes’ likenesses.”³⁶³ Judge Thomas argued that the “majority confines its inquiry to how a single athlete’s likeness is represented in the video game, rather than examining the transformative and creative elements in the video game as a

357. *Id.* at 175 (Ambro, J., dissenting).

358. *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268, 1274 (9th Cir. 2013).

359. *Id.* at 1279–82. The Ninth Circuit found that the “history and development of the *Rogers* test makes clear[] [that] it was designed to protect consumers from the risk of consumer confusion,” and “[t]he right of publicity protects the *celebrity*, not the *consumer*.” *Id.* at 1280–81.

360. *Id.* at 1274. For the five factors, see *supra* notes 250–254 and accompanying text.

361. *Keller*, 724 F.3d at 1279.

362. *Id.* at 1284 (Thomas, J., dissenting).

363. *Id.*

whole.”³⁶⁴ According to Judge Thomas, the majority’s approach “contradicts the holistic analysis required by the transformative use test,”³⁶⁵ which asks “whether the entire work is transformative, and whether the transformative elements predominate, rather than whether an individual persona or image has been altered.”³⁶⁶

Judge Thomas described *NCAA Football* as a “work of interactive historical fiction” that allows the player to roleplay as a potential college football player or a football coach.³⁶⁷ The game also gives the player the power to alter the virtual players’ “abilities, appearances, and physical characteristics,” and even “create new virtual players.”³⁶⁸ Moreover, players can change teams and environmental factors such as “weather, crowd noise, [and] mascots.”³⁶⁹ Even if the player simply plays an unaltered version of the game, “the work is one of historic[al] fiction” because the “gamer controls the teams, players, and games.”³⁷⁰ Thus, “considered as a whole,” *NCAA Football* is “primarily one of EA’s own expression,” with “[t]he athletic likenesses . . . [merely] one of the raw materials from which the broader game is constructed.”³⁷¹ Indeed, the “creative and transformative elements predominate over the commercial use of likenesses”; the “marketability and economic value of the game comes from” its “creative elements, not from . . . [any] commercial exploitation of a celebrity”; and “[t]he game is not a conventional portrait of a celebrity, but a work consisting of many creative and transformative elements.”³⁷²

Moreover, Judge Thomas found the depiction of football players in *NCAA Football* more akin to the depiction of Ulala in *Kirby* than to the depiction of the band in *No Doubt*.³⁷³ While he distinguished *No Doubt* on the ground that the “literal representations in *No Doubt* were not, and could not be, transformed in any way,”³⁷⁴ he also noted that, “to the extent that the Court of

364. *Id.* at 1285 (Thomas, J., dissenting).

365. *Id.* (citing *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170–76 (3d. Cir. 2013) (Ambro, J., dissenting)).

366. *Id.*

367. *Id.*

368. *Id.* at 1286.

369. *Id.*

370. *Id.*

371. *Id.*

372. *Id.*

373. *Id.* at 1286–87.

374. *Id.* at 1286.

Appeal's opinion in *No Doubt* may be read to be in tension with the transformative use test as articulated by the California Supreme Court in *Comedy III* and *Winter*, it must yield.³⁷⁵ Thus, Judge Thomas “would not punish EA for the realism of its games and for the skill of the artists who created realistic settings for the football games.”³⁷⁶

Judge Thomas went even further. Among other things, he focused on *Comedy III*'s requirement that courts examine “whether the source of the product marketability comes from creative elements or from pure exploitation of a celebrity image.”³⁷⁷ “*NCAA Football* includes not just Sam Keller, but thousands of virtual actors,” and “one could play *NCAA Football* thousands of times without ever encountering a particular avatar.”³⁷⁸ The “sheer number of athletes involved inevitably diminish[es] the significance of the publicity right at issue” and “underscores the inappropriateness of analyzing the right of publicity through the lens of one likeness only.”³⁷⁹

Finally, Judge Thomas warned that “[t]he logical consequence of the majority view is that all realistic depictions of actual persons, no matter how incidental, are protected by a state law right of publicity regardless of the creative context.”³⁸⁰ This result would “jeopardize[] the creative use of historic figures in motion pictures, books, and sound recordings,” and “cannot be reconciled with the many cases affording such works First Amendment protection.”³⁸¹

375. *Id.* at 1287 n.3.

376. *Id.* at 1287.

377. *Id.*

378. *Id.* at 1287–88.

379. *Id.* Judge Thomas's discussion of *No Doubt*, unfortunately, is inaccurate. *See id.* at 1288. He suggests “*Kirby* and *No Doubt* involved pivotal characters in a video game” where “[t]he commercial image of the celebrities in each case was central to the production, and its contact with the consumer was immediate and unavoidable.” *Id.* That was true in *Kirby* since Ulala is the main protagonist in *Space Channel 5*. *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 610 (Cal. Ct. App. 2006). But in *No Doubt*, players could play *Band Hero* without ever encountering the likenesses of *No Doubt*'s members, who represented only one of the many choices players had in deciding upon the avatars to represent their band. *See No Doubt v. Activision Publ'g Inc.*, 122 Cal. Rptr. 3d 397, 400 (Cal. Ct. App. 2011).

380. *Keller*, 724 F.3d at 1290 (Thomas, J., dissenting).

381. *Id.* The majority responded that its analysis “leaves room for distinguishing between this case—where we have emphasized EA's primary emphasis on reproducing reality—and cases involving other kinds of expressive works.” *Id.* at 1279 n.10. This very statement suggests there is a distinction between video games and other expressive works and shows the majority views video games as less deserving of First Amendment protection than those other works. *See infra* Section V.B.

3. *Davis v. Electronic Arts, Inc.*

Davis v. Electronic Arts, in which former NFL players sued EA for using their likenesses in *Madden NFL*,³⁸² is nearly identical to *Brown v. Electronic Arts*.³⁸³ But while *Brown* sued under the Lanham Act,³⁸⁴ the plaintiffs in *Davis* sued under a state law right of publicity theory.³⁸⁵ And that made all the difference: The Ninth Circuit found the facts and arguments were largely indistinguishable from *Keller*, and held it was bound by its previous decision.³⁸⁶ Thus, the court declined to apply the *Rogers* test, and instead applied the transformative use test and concluded EA's use of the players' likenesses in *Madden NFL* was not transformative.³⁸⁷

4. *Hamilton v. Speight*

In *Hamilton v. Speight*, Lenwood Hamilton, a former professional wrestler and football player, alleged the publishers of the *Gears of War* video games used his wrestling identity Hard Rock Hamilton to create the character Augustus Cole.³⁸⁸ “*Gears of War* is an extremely violent cartoon-style fantasy video game series. The series takes place on an Earth-like planet called Sera that is populated by a wide variety of post-apocalyptic, crumbling structures.”³⁸⁹ The games mainly follow “a military unit called Delta Squad,” which includes Cole, and its conflicts with “a race of exotic reptilian humanoids known as the Locust Horde.”³⁹⁰

The Eastern District of Pennsylvania applied the transformative use test

382. *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1175 (9th Cir. 2015).

383. Compare *Davis*, 775 F.3d at 1175 (“We are called upon to balance the right of publicity of former professional football players against Electronic Arts’ (EA) First Amendment right to use their likenesses in its *Madden NFL* series of video games.”), with *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1238 (9th Cir. 2013) (“[R]etired professional football player Jim[] Brown[] . . . alleg[ed] that Electronic Arts, Inc., violated § 43 of the Lanham Act through the use of his likeness in its *Madden NFL* series of video games.”).

384. *Brown*, 724 F.3d at 1238.

385. *Davis*, 775 F.3d at 1176.

386. *Id.* at 1178.

387. *Id.* at 1177–79.

388. *Hamilton v. Speight*, 413 F. Supp. 3d 423, 425–27 (E.D. Pa. 2019), *aff’d*, No. 19-3495, 2020 WL 5569454 (3d Cir. Sept. 10, 2020).

389. *Id.* at 426.

390. *Id.*

and found Cole was transformative for two reasons.³⁹¹ First, while Hamilton and Cole shared some physical similarities, Hamilton’s identity was “obviously not the ‘very sum and substance’ of the Cole character’s identity.”³⁹² Cole’s biographical information, clothing, and persona were all different from Hamilton’s.³⁹³ “Second, the context in which the Cole character appears and performs is profoundly transformative” because Cole “engages in extraordinarily stylized and fantastical violence against cartoonish reptilian humanoids on a fictional planet in a fictional war [and] ‘does not do[] what the actual’ . . . Hamilton . . . does—engage in professional wrestling on Earth.”³⁹⁴ In short, the court found, the case before it was nearly identical to *Kirby*.³⁹⁵

In a short unpublished opinion, the Third Circuit affirmed the district court’s order.³⁹⁶ The court found that “no reasonable jury could conclude that Hamilton—whether Lenwood or Hard Rock—is the ‘sum and substance’ of the Augustus Cole character.”³⁹⁷ Although it found some similarities, it also found other “significant differences” that “reveal that Hamilton was, at most, one of the ‘raw materials from which [Augustus Cole] was synthesized.”³⁹⁸ In particular, Hamilton does not “fight[] a fantastic breed of creatures in a fictional world,” has never served in the military, and “admits that the Cole character’s persona is alien to him.”³⁹⁹ In short, the Third Circuit concluded, “[i]f Hamilton was the inspiration for Cole, the likeness has been ‘so transformed that it has become primarily the defendant’s own expression.”⁴⁰⁰

5. *Pellegrino v. Epic Games, Inc.*

In 2017, Epic Games released the battle royale game *Fortnite*.⁴⁰¹ The battle royale genre “blends the survival, exploration and scavenging elements of a survival game with last-man-standing gameplay,” where ““up to 100

391. *Id.* at 431.

392. *Id.* at 431; *see also id.* at 431–33 (discussing this holding in more detail).

393. *Id.* at 431–32.

394. *Id.* at 431 (second alteration in original).

395. *See id.* at 432.

396. *Hamilton v. Speight*, No. 19-3495, 2020 WL 5569454 (3d Cir. Sept. 17, 2020).

397. *Id.* at *2 (footnote omitted).

398. *Id.*

399. *Id.*

400. *Id.* at *3.

401. *Pellegrino v. Epic Games, Inc.*, 451 F. Supp. 3d 373, 378 (E.D. Pa. 2020).

players, alone, in pairs or in groups, compete to be the last player or group alive' by using weapons and other forms of violence to eliminate other players."⁴⁰² In 2018 and 2019, numerous plaintiffs sued Epic claiming it used their dance moves as emotes⁴⁰³ in *Fortnite* without permission.⁴⁰⁴ The initial battle resulted in the plaintiffs withdrawing their copyright claims, and some plaintiffs dismissing their cases altogether.⁴⁰⁵ A few, however, continued to pursue their trademark and right of publicity claims—including Leo Pellegrino, who alleged Epic's "Phone It In" emote constituted unauthorized use of his likeness by using his "Signature Move" dance.⁴⁰⁶

In March 2020, the Eastern District of Pennsylvania granted Epic's motion to dismiss on all claims but one—Pellegrino's false endorsement claim.⁴⁰⁷ As for Pellegrino's right of publicity claims, the court applied the transformative use test the Third Circuit adopted in *Hart*.⁴⁰⁸ It found Epic had sufficiently transformed Pellegrino's likeness in at least two ways: *Fortnite* avatars "do not share Pellegrino's identity nor do what Pellegrino does in real life."⁴⁰⁹ *Fortnite* avatars using the "Phone It In" emote do not "share Pellegrino's appearance or biographical information."⁴¹⁰ Moreover, *Fortnite*

402. *Id.*

403. *Id.* Emotes are "customizations for the *Fortnite* digital avatars" that enable them to "perform dances or movements." *Id.* (emphasis added). Emotes are popular because they "allow players to personalize their *Fortnite* experience." *Id.* (emphasis added).

404. *See id.* At least seven lawsuits were filed against Epic. *See Pellegrino*, 2020 WL 1531867 ("Signature Move" dance); *Brantley v. Epic Games, Inc.*, No. 8:19-cv-00594-PWG (D. Md. Filed Feb. 25, 2019) ("Running Man" dance); *Baker v. Epic Games, Inc.*, No. 2:19-cv-00505 (C.D. Cal. Filed Jan. 23, 2019) ("Shoot" dance); *McCumbers v. Epic Games, Inc.*, No. 2:19-cv-00260 (C.D. Cal. Filed Jan. 11, 2019) ("Random" dance); *Redd v. Epic Games, Inc.*, No. 2:18-cv-10444 (C.D. Cal. Filed Dec. 17, 2018) ("Floss Dance"); *Ribeiro v. Epic Games, Inc.*, No. 2:18-cv-10412 (C.D. Cal. filed Dec. 17, 2018) ("Carlton" dance); *Ferguson v. Epic Games, Inc.*, No. 2:18-cv-10110 (C.D. Cal. filed Dec. 5, 2018) ("Milly Rock" dance). Several of these plaintiffs also filed similar lawsuits against Take-Two over dance emotes in *NBA 2K*. *See Ferguson v. Take-Two Interactive Software, Inc.*, No. 2:18-cv-10425 (C.D. Cal. Filed Dec. 17, 2018); *Ribeiro v. Take-Two Interactive Software, Inc.*, No. 2:18-cv-10417 (C.D. Cal. Filed Dec. 17, 2018); *Redd v. Take-Two Interactive, Inc.*, No. 2:18-cv-10441 (C.D. Cal. Filed Dec. 17, 2018).

405. *See generally, e.g.,* Meaghan H. Kent et al., *Gaming Emote Litigation: Battle Royale Ensues Over Fortnite Emotes with Plaintiffs Testing Different Causes of Action*, VENABLE LLP (Apr. 21, 2020), <https://www.venable.com/insights/publications/2020/04/gaming-emote-litigation-battle-royale-ensues-over> (discussing the various copyright claims).

406. *Pellegrino*, 451 F. Supp. 3d at 378–79.

407. *Id.* at 391–92.

408. *Id.* at 380–81.

409. *Id.* at 381.

410. *Id.*

avatars fight in a battle royale and use emotes “amidst ‘us[ing] weapons and violence to eliminate the competition,” while Pellegrino is a “musical performer who executes his Signature Move at musical performances.”⁴¹¹ While the court did not directly address whether the creative and transformative elements predominate over the commercial use of Pellegrino’s likeness, or whether the marketability and economic value of *Fortnite* came from its creative elements or from the commercial exploitation of Pellegrino’s image, the court did note that “*Fortnite* players can customize their avatars with ‘new characters’ and a variety of emotes mimicking celebrities other than Pellegrino.”⁴¹²

6. A Non-Video Game Case for Comparison: *Sarver v. Chartier*

In 2004, journalist Mark Boal was embedded with a U.S. Army Explosive Ordnance Disposal team in Iraq.⁴¹³ He followed and took photographs and videos of Army Sergeant Jeffrey Sarver, and he also interviewed Sarver after their return to the United States.⁴¹⁴ “Boal later wrote the screenplay for the film . . . *The Hurt Locker*,” which follows the protagonist William James and a U.S. Army Explosive Ordnance Disposal team in Iraq.⁴¹⁵ Sarver sued for violation of his right of publicity, alleging his likeness was used to create James.⁴¹⁶

In contrast to *Keller* and *Davis*, the Ninth Circuit did not apply the transformative use test in *Sarver* before holding that the First Amendment barred Sarver’s claim.⁴¹⁷ The court found “California’s right of publicity law clearly restricts speech based upon its content,” and therefore is “presumptively unconstitutional and may be justified only if the government proves that [it is] narrowly tailored to serve compelling state interests.”⁴¹⁸ The

411. *Id.* (alteration in original).

412. *Id.* (italics added). In May 2020, the District of Maryland dismissed the plaintiffs’ claims against Epic in *Brantley* on copyright preemption grounds without reaching Epic’s First Amendment arguments. *Brantley v. Epic Games, Inc.*, No. 8:19-cv-594-PWG, 2020 WL 2794016, at *1 (D. Md. May 29, 2020).

413. *Sarver v. Chartier*, 813 F.3d 891, 896 (9th Cir. 2016).

414. *Id.*

415. *Id.* For a review of the film, see Peter Bradshaw, *The Hurt Locker*, THE GUARDIAN (Aug. 28, 2009, 3:25 AM), <https://www.theguardian.com/film/2009/aug/28/the-hurt-locker-review>.

416. *Sarver*, 813 F.3d at 896.

417. *See id.* at 905–06.

418. *Id.* at 903 (quoting *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015)).

court then held that the state’s interest in permitting a right of publicity claim can survive strict scrutiny only if the defendant’s work “appropriates the economic value of a performance or persona or seeks to capitalize off a celebrity’s image in commercial advertisements.”⁴¹⁹ It found “*The Hurt Locker* is not speech proposing a commercial transaction” and that telling Sarver’s story did not steal his “‘entire act’ or otherwise exploit[] the economic value of any performance or persona he had worked to develop.”⁴²⁰ Thus, *The Hurt Locker* was “fully protected by the First Amendment, which safeguards the storytellers and artists who take the raw materials of life—including the stories of real individuals, ordinary or extraordinary—and transform them into art, be it articles, books, movies, or plays.”⁴²¹

V. A BETTER TEST TO BALANCE THE FIRST AMENDMENT WITH THE RIGHT OF PUBLICITY

A. *The Need to Apply Strict Scrutiny and a Consistent Test that Respects the First Amendment’s Protection of Video Games*

The preceding parts discussed two different legal theories that often result in different outcomes despite involving similar facts. For claims arising from the Lanham Act, courts apply the *Rogers* test and often conclude the First Amendment protects the video game from the plaintiff’s claim.⁴²² By contrast, for right of publicity claims, courts apply the transformative use test and often reach the opposite conclusion.⁴²³ This contrast is best highlighted in *Brown v. Electronic Arts, Inc.* and *Davis v. Electronic Arts, Inc.* In both cases, former NFL players sued EA over the use of their likenesses in *Madden NFL*. But Brown brought his claim under the Lanham Act, while Davis brought his claim under the right of publicity. That made all the difference.⁴²⁴

419. *Id.* at 905.

420. *Id.*

421. *Id.*

422. *See, e.g., Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1248 (9th Cir. 2013) (“Brown’s Lanham Act claim is thus subject to the *Rogers* test, and we agree with the district court that Brown has failed to allege sufficient facts to make out a plausible claim that survives that test.”).

423. *See, e.g., Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1181 (9th Cir. 2015) (“EA has not shown that its unauthorized use of former players’ likenesses in the *Madden NFL* video game series qualifies for First Amendment protection under the transformative use defense.”).

424. *Compare Brown*, 724 F.3d at 1248 (“Brown’s Lanham Act claim is thus subject to the *Rogers* test, and we agree with the district court that Brown has failed to allege sufficient facts to make out a

The Ninth Circuit found the First Amendment protected *Madden NFL* against Brown's claim but not against Davis's claim. And after Brown lost his appeal on his Lanham Act claim in the Ninth Circuit, he filed a right of publicity claim in state court—and won.⁴²⁵

The different results in these cases make some theoretical sense. The Lanham Act's goals are to prevent consumer confusion and to protect mark owners and individuals from false advertising or endorsement, while the right of publicity seeks to protect a form of intellectual property right in an individual.⁴²⁶ Thus, the right of publicity offers broader protections than the Lanham Act does.⁴²⁷ But this in fact means courts should give more, not less, weight to the First Amendment in the right of publicity context. Indeed, courts have recognized that “publicity rights carry a greater danger of impinging on First Amendment rights than do rights” under the Lanham Act.⁴²⁸ By prohibiting expression that includes another's name or likeness, the right of publicity is a content-based restriction on speech that should be subject to strict scrutiny.⁴²⁹ Any test balancing the right of publicity with the First

plausible claim that survives that test.”), with *Davis*, 775 F.3d at 1181 (“EA has not shown that its unauthorized use of former players' likenesses in the *Madden NFL* video game series qualifies for First Amendment protection under the transformative use defense.”).

425. See *After Being Tripped Up By the Lanham Act, Jim Brown Rushes at Electronic Arts with a Right of Publicity Claim*, CROWELL & MORING (Oct. 24, 2013), <https://www.crowell.com/NewsEvents/AlertsNewsletters/all/After-Being-Tripped-Up-By-the-Lanham-Act-Jim-Brown-Rushes-at-Electronic-Arts-with-a-Right-of-Publicity-Claim>; *NFL Legend Jim Brown Takes Judgment in Likeness Case Against Electronic Arts*, HAGENS BERMAN (June 27, 2016), <https://www.hbsslaw.com/cases/jim-brown-publicity-rights/pressrelease/jim-brown-publicity-rights-nfl-legend-jim-brown-takes-judgment-in-likeness-case-against-electronic-arts>.

426. See THE RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 202, §§ 5:6–5:9 (describing differences between trademark rights and rights of publicity).

427. See *Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003) (“Because a plaintiff bears a reduced burden of persuasion to succeed in a right of publicity action, courts and commentators have recognized that publicity rights carry a greater danger of impinging on First Amendment rights than do rights associated with false advertising claims.”); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996) (“Although publicity rights are related to laws preventing false endorsement, they offer substantially broader protection[s].”); *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1996) (“Because the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement, it is potentially more expansive than the Lanham Act.”).

428. *Parks*, 329 F.3d at 460.

429. See *Sarver v. Chartier*, 813 F.3d 891, 903 (9th Cir. 2016); *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 461–62 (Cal. 1979) (Bird, C.J., concurring). Many commentators have adopted this view. See, e.g., Mark Conrad, *A New First Amendment Goal Line Defense—Stopping the Right of Publicity Offense*, 40 OHIO N.U. L. REV. 743, 789 (2014); F. Jay Dougherty, *All the World's Not A Stooge: The 'Transformativeness' Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J. L. & ARTS 1, 46, 61 (2003);

Amendment must reflect this.⁴³⁰

Despite their differences, the Lanham Act and the right of publicity do share some similarities. Both grant an individual the right to protect an economic interest in their name and likeness, and both require courts to balance the respective right against the First Amendment. Thus, while a Lanham Act claim is not necessarily “the federal equivalent of the right of publicity,”⁴³¹ their similarities merit consideration of a single test applicable to both types of claims.⁴³²

B. Criticism of the Transformative Use Test in the Video Game Context and Courts’ Failure to Treat Video Games as Expressive Works

Several commentators have proposed applying the transformative use test to Lanham Act claims as well as right of publicity claims in the video game context.⁴³³ For example, proposals have been made (1) to use the transformative use test for both types of claims,⁴³⁴ (2) to add the transformative use test to the *Rogers* test and then to apply that modified test to both Lanham Act and right of publicity claims,⁴³⁵ and (3) to combine the transformative use test and a “modified likelihood of confusion test”⁴³⁶ when evaluating Lanham Act claims, while leaving the transformative use test alone when evaluating right of publicity claims.⁴³⁷

Proposals to use the transformative use test in Lanham Act claims fail to give sufficient weight to the First Amendment. Indeed, the transformative use test should not apply to video games at all, regardless of whether the plaintiff

Volokh, *supra* note 327, at 912 n.35; Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART & ENT. L. 35, 53–54 (1998).

430. See *supra* note 429 and accompanying text. This is one of the areas in which the Ninth Circuit failed in *Keller*. *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268 (9th Cir. 2013). It recognized the *Rogers* test provides a “broader First Amendment defense,” but rejected it in favor of the transformative use test. *Id.* at 1279.

431. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003).

432. See Ford & Liebler, *supra* note 21, at 80–81.

433. See Papazian, *supra* note 9; Kimberly Rubin, *The Key to Being a Good Referee: The Call the Ninth Circuit Missed when Evaluating False Endorsement Claims*, 64 EMORY L.J. 1389 (2015); Wesley W. Wintermyer, *Who Framed Rogers v. Grimaldi?: What Protects Trademark Holders Against First Amendment Immunity for Video Games?*, 64 ALA. L. REV. 1243 (2013).

434. Wintermyer, *supra* note 433, at 1256–61.

435. Papazian, *supra* note 9, at 596–602.

436. Rubin, *supra* note 433, at 1393.

437. Rubin, *supra* note 433, at 1423–27.

alleges a Lanham Act claim or a right of publicity claim.⁴³⁸ The California Court of Appeal said in *de Havilland* that the transformative use test “makes sense when applied to products and merchandise” but suggested it makes less sense when applied to “expressive works such as films, plays, and television programs.”⁴³⁹ Likewise, the Ninth Circuit’s decision in *Sarver* confirms the transformative use test is unnecessary to balance the First Amendment with the right of publicity for expressive works.⁴⁴⁰

The result the transformative use test would have on games depicting real-life scenarios or real people further shows the impropriety of applying that test to expressive works such as video games.⁴⁴¹ Realism alone is a legitimate artistic goal, and the use of a likeness in an expressive work to achieve realism has expressive value.⁴⁴² But under the transformative use test, that selfsame goal would defeat a video game publisher’s First Amendment rights.⁴⁴³ The more accurate and real a depiction of a likeness, the less transformative it necessarily will be.⁴⁴⁴ One need not look further than *No Doubt*, *Hart*, *Keller*, and *Davis* for examples involving realistic depictions of people.⁴⁴⁵ But a test that punishes realism in video games cannot be squared with the protection given to realistic depictions in other expressive works, suggesting the transformative use test has no place here.⁴⁴⁶

438. See, e.g., Geoffrey F. Palachuk, *Transformative Use Test Cannot Keep Pace with Evolving Arts*, 16 U. DEN. SPORTS & ENT. L.J. 233, 259, 277 (2014) (“The transformative use test . . . is not the correct test. That test will result in incoherent and inconsistent application, and chill First Amendment protections granted by the United States Constitution.”); Wee Jin Yeo, *Disciplining the Right of Publicity’s Nebulous First Amendment Defense with Teachings from Trademark Law*, 34 CARDOZO ARTS & ENT. L.J. 401, 426, 439–40 (2016) (delineating the inadequacies of the transformative use test).

439. *de Havilland v. FX Networks, LLC*, 230 Cal. Rptr. 3d 625, 641 (Cal. Ct. App. 2018), cert. denied, 139 S. Ct. 800 (2019).

440. See *supra* notes 418–421 and accompanying text.

441. See Thomas E. Kadri, *Fumbling the First Amendment: The Right of Publicity Goes 2–0 Against Freedom of Expression*, 112 MICH. L. REV. 1519, 1525 (2014) (“The transformative use test is unwieldy and verbose. It tempts courts to judge the artistic value of expressive works in a manner that censors speech and belittles our rich First Amendment tradition.”); *infra* notes 442–446.

442. See, e.g., *Brown v. Elec. Arts*, 724 F.3d 1235, 1243 (9th Cir. 2013); *AM Gen. LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467, 484–85 (S.D.N.Y. 2020).

443. See Kadri, *supra* note 441, at 1525–26.

444. See *de Havilland*, 230 Cal. Rptr. 3d at 630.

445. See *Davis v. Elec. Arts, Inc.* 775 F.3d 1172, 1177–78 (9th Cir. 2015); *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268, 1276–79 (9th Cir. 2013); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165–69 (3d Cir. 2013); *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397, 400–01 (Cal. Ct. App. 2011).

446. See, e.g., *de Havilland*, 21 Cal. Rptr. 3d at 630. A company seeking a realistic depiction of a

As a practical problem, the transformative use test stifles creativity and creates a chilling effect over any video game (indeed, any expressive work) that depicts real-life scenarios or real people.⁴⁴⁷ History shows many examples of threats over depictions of entities or individuals in films that resulted in changes that might be less accurate.⁴⁴⁸ One can only imagine if individuals depicted in *The People v. O.J. Simpson: American Crime Story* could have prevented its creators from telling that story without portraying them or their families more favorably.⁴⁴⁹ These tactics also occur in the video game context. One commentator cites *VIRAG* in discussing “trademark bullies” who use litigation “as a weapon to silence content creators”—or to extract large settlements.⁴⁵⁰ Another example is the demand by Pinkerton Consulting & Investigations for royalties from Rockstar and Take-Two for each copy of *Red Dead Redemption 2* sold, after news broke about the revenue and sales numbers the game had achieved.⁴⁵¹ And perhaps the best examples

person already has incentive to work with the person to ensure an accurate depiction, as seen in one recent example involving Activision Blizzard approaching Tu Lam to collaborate on incorporating his likeness as Daniel “Ronin” Shinoda into *Call of Duty: Modern Warfare*. See James Mattone, *The Real Ronin: An Interview with Tu Lam*, ACTIVISION GAMES BLOG (Apr. 28, 2020), <https://blog.activision.com/call-of-duty/2020-04/The-Real-Ronin-An-Interview-with-Tu-Lam>. Works intending to accurately depict real events or people but failing to do so will often receive criticism for that very reason. See Anthony Zangrillo, *The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 385, 388–89 (2017) (delineating the horrible reviews a film received after having to alter the events portrayed in the film so as not to depict real events without being “transformative”).

447. See Kadri, *supra* note 441, at 1528–29; *infra* notes 450–452 and accompanying text.

448. See Zangrillo, *supra* note 446, at 388–89.

449. See, e.g., Joanna Robinson, *Mark Fuhrman Slams The People v. O.J. Simpson for Political Correctness*, VANITY FAIR (Mar. 7, 2016), <https://www.vanityfair.com/hollywood/2016/03/mark-fuhrman-people-v-og-simpson>. In this article, Mark Fuhrman, the LAPD Detective who found the famous bloody glove, suggested the TV series does not accurately portray him and complained that FX “is attempting to establish a historical artifact with this series without reaching out to any prosecution sources.” *Id.*

450. Zangrillo, *supra* note 446, at 423–24.

451. See Press Release, *Red Dead Redemption 2 Achieves Entertainment’s Biggest Opening Weekend of All Time*, BUS. WIRE (Oct. 30, 2018, 8:00 AM), <https://www.businesswire.com/news/home/20181030005459/en>. In late October 2018, Rockstar announced that *Red Dead Redemption 2* had sold more than \$725 million in the first three days of its release and set multiple records. *Id.* Less than two months later, Pinkerton sent the cease and desist letter to Rockstar and Take-Two, which responded by filing a declaratory judgment action in the Southern District of New York. See Declaratory Judgment Action, *Take-Two Interactive Software, Inc. v. Pinkerton Consulting & Investigations, Inc.*, No. 19-cv-338 (S.D.N.Y. Jan. 11, 2019). In April 2019, Rockstar and Take-Two dismissed the action, stating that Pinkerton had withdrawn its claims for royalties. See Ryan Meyer, *The Take-Two Interactive v. Pinkerton Showdown Has Ended in a Draw*, JDSUPRA (Apr. 25,

come from *Hart* and *Keller*, in which the NCAA's rules regarding amateurism at the time meant the plaintiffs' victories in those cases destroyed *NCAA Football* altogether.⁴⁵²

Moreover, the California Court of Appeal acknowledged in *de Havilland* that courts have "struggled mightily" to "figure out how to apply" the transformative use test to expressive works.⁴⁵³ That struggle arises from the subjectivity of the test, which requires courts to make qualitative judgments over whether a mark or likeness is sufficiently artistic or creative and transformed within an expressive work to merit First Amendment protection.⁴⁵⁴ In *Comedy III*, the California Supreme Court played this subjective role by determining that an artist's sketch of The Three Stooges on lithographs and t-shirts did not merit First Amendment protection, while stating that Andy Warhol's portraits of celebrities likely would.⁴⁵⁵ It even recognized that the distinction between works that are protected by the First Amendment and those that are not will "sometimes be subtle."⁴⁵⁶

As Justice Holmes said more than a century ago, "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."⁴⁵⁷ This principle applies in greater force today to video games, a newer form of expressive work compared to traditional entertainment media.⁴⁵⁸ The subjective transformative use test might be appropriate in copyright law as one of many factors to determine the application of a fair use defense, but it is inappropriate for Lanham Act claims

2019), <https://www.jdsupra.com/legalnews/the-take-two-interactive-v-pinkerton-63564>.

452. See *NCAA FOOTBALL* (Electronic Arts 2013) (final installment of the *NCAA Football* series). As *Hart* explains, NCAA rules did not allow college athletes to accept remuneration or permit the use of their likenesses to "advertise, recommend or promote directly the sale or use of a commercial product or service of any kind." *Hart v. Elec. Arts, Inc.*, 714 F.3d 141, 145 (3d Cir. 2013). Thus, EA could not pay college football players for the right to use their likenesses in any video game. See *id.* This topic has been the subject of much discussion, many lawsuits, and even legislative action beyond the scope of this article. See, e.g., Justin W. Aimonetti & Christian Talley, *Game Changer: Why and How Congress Should Preempt State Student-Athlete Compensation Regimes*, 72 STAN. L. REV. ONLINE 28, 32 (2019–2020) (addressing "the student-athlete compensation dilemma").

453. *de Havilland v. FX Networks, LLC*, 230 Cal. Rptr. 3d 625, 641 (Cal. Ct. App. 2018), *cert. denied*, 139 S. Ct. 800 (2019).

454. See Palachuk, *supra* note 438, at 263–64.

455. *Comedy III Prods., Inc., v. Gary Saderup, Inc.*, 21 P.3d 797, 810–11 (Cal. 2001).

456. *Id.* at 811.

457. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

458. See Kadri, *supra* note 441, at 1528.

and right of publicity claims when First Amendment rights are at stake.⁴⁵⁹

The differences in the results reached by California state courts highlight the subjectivity of the transformative use test.⁴⁶⁰ One can argue that the No Doubt likenesses in *Band Hero* depicted No Doubt's members as they appeared in real life and doing what they did in real life,⁴⁶¹ while Ulala in *Space Channel 5* and CJ in *San Andreas* did not depict Kirby or Washington as they appeared in real life or doing what they did in real life.⁴⁶² But that argument fails when considering *Noriega*, where the court found the depiction of Noriega was transformative even though Activision used real life photographs to create Noriega's likeness and depicted him in the same role he served in real life.⁴⁶³ The true difference, it seems, is that the court in *No Doubt* simply refused to consider the other expressive elements of *Band Hero* and instead focused solely on the depiction of No Doubt.⁴⁶⁴ The most likely explanation is that the court believed the game had little value as an expressive work.

A comparison between *No Doubt* and *de Havilland* further illustrates the problems with the transformative use test. In *de Havilland*, the court pointed out that the de Havilland character appears only in 4.2 percent of *Feud*, which focuses on the competition between two other characters and includes many other stories as well.⁴⁶⁵ The court also found that FX used de Havilland's

459. See, e.g., Conrad, *supra* note 429, at 780–83; Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1187–89 (2006); Volokh, *supra* note 327, at 910, 922 (explaining the problems with analogizing the right of publicity to copyright law and importing the transformative use test from copyright's fair use analysis to the right of publicity context).

460. See *supra* notes 258–312 and accompanying text.

461. *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 401 (Cal. Ct. App. 2011) (explaining how, in *Band Hero*, players can perform songs using “digital representations of real-life rock stars”).

462. See *Kirby v. Sega of Am., Inc.* 50 Cal. Rptr. 3d 607, 609–610 (Cal. Ct. App. 2006) (explaining that Kirby is “the lead singer of a retro-funk dance musical group” and Ulala is an outer space news reporter who is “dispatched to investigate an invasion of Earth by dance-loving aliens” and must “match the dance moves of [] other characters”); *Washington v. Take-Two Interactive Software, Inc.*, No. B232929, 2012 WL 5358709, at *11 (Cal. Ct. App. Oct. 31, 2012) (explaining how much CJ and Washington differ, and how many aspects of CJ's character have no resemblance or connection to Washington's life).

463. *Noriega v. Activision/Blizzard, Inc.*, No. BC 551747, 2014 WL 5930149, *3–4 (Cal. Super. Ct. Oct. 27, 2014).

464. See *No Doubt*, 50 Cal. Rptr. 3d at 410–12 (focusing on the depiction of No Doubt in the game when deciding whether the game is transformative).

465. *de Havilland v. FX Networks, LLC*, 230 Cal. Rptr. 3d 625, 641 (Cal. Ct. App. 2018), *cert. denied*, 139 S. Ct. 800 (2019).

likeness only as “one of the ‘raw materials’ from which [the] original work is synthesized,” and that *Feud’s* marketability and economic value came “‘principally from . . . the creativity, skill, and reputation’ of *Feud’s* creators and actors”—not from de Havilland’s fame.⁴⁶⁶

The same could be said about the depiction of No Doubt in *Band Hero*.⁴⁶⁷ The band members’ likenesses only constituted a small fraction of *Band Hero*, a game that focuses on allowing “players to simulate performing in a rock band in time with popular songs.”⁴⁶⁸ Even among avatars, *Band Hero* included other “fictional characters created and designed by Activision, . . . digital representations of real-life rock stars” besides No Doubt, and the ability for players to “design their own unique fictional avatars.”⁴⁶⁹ And it is much more likely that *Band Hero’s* marketability and economic value derived mainly from its gameplay and Activision’s reputation as a video game publisher, not from No Doubt’s fame.⁴⁷⁰ But the court ignored these elements of *Band Hero*. Instead, it concluded that “the graphics and other background content of the game are secondary, and the expressive elements of the game remain ‘manifestly subordinated to the overall goal of creating a conventional portrait of [No Doubt] so as to commercially exploit [its] fame.’”⁴⁷¹ The court said that “nothing in the creative elements of the *Band Hero* elevates the depictions of No Doubt to something more than ‘conventional, more or less fungible,’ images of its members that No Doubt should have the right to control and exploit.”⁴⁷²

Again, the difference between the two cases appears to be the *No Doubt* court’s sole focus on the depictions of No Doubt’s likenesses while ignoring the rest of *Band Hero*.⁴⁷³ The analyses and results in *No Doubt* and *de*

466. *Id.* (alterations in original) (quoting *Comedy III Prods., Inc., v. Gary Saderup, Inc.*, 21 P.3d 797, 809–810 (Cal. 2001)).

467. *No Doubt*, 50 Cal. Rptr. 3d at 410–12. For a similar perspective on *No Doubt* but without a comparison to *de Havilland*, see *So Are Games Coffee Mugs or What?*, *supra* note 21, at 192.

468. *No Doubt*, 122 Cal. Rptr. 3d at 401.

469. *Id.*

470. *Id.* (explaining the gameplay of *Band Hero* and its immense popularity).

471. *Id.* at 411 (alterations in original) (quoting *Comedy III Prods., Inc., v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001)).

472. *Id.* (quoting *Comedy III*, 21 P.3d at 808).

473. See *So Are Games Coffee Mugs or What?*, *supra* note 21, at 192 (“Context matters, except when it doesn’t. The court treated the transformative test as one that requires some visual change to the portrayal of the plaintiffs, focusing on the avatars in the game rather than the game as a whole.”). Compare *No Doubt*, 122 Cal. Rptr. 3d at 410–11 (analyzing the characterized likeness of No Doubt in performing “the same activity by which the band achieved and maintains its fame” and merely

Havilland cannot be reconciled. If the creators of a television series can portray a real person without acquiring her permission, why can't the creator of a video game do so? And why did FX's use of de Havilland's likeness in *Feud* constitute transformative use,⁴⁷⁴ but Activision's use of No Doubt's likenesses in *Band Hero* did not?⁴⁷⁵ The simplest answer⁴⁷⁶ can be found in the courts' own statements comparing video games not to other expressive works, but to products and merchandise. In at least four recent cases, courts have suggested that video games merit less First Amendment protection than other expressive works.⁴⁷⁷

First, in *de Havilland*, the California Court of Appeal distinguished "expressive works such as films, plays, and television programs" from "products and merchandise such as T-shirts and lithographs, greeting cards, and video games, or advertisements for products and merchandise."⁴⁷⁸ Second, in *Keller*, Judge Thomas's dissent warned that the majority's opinion would jeopardize "the creative use of historic figures in motion pictures, books, and sound recordings," and "cannot be reconciled with the many cases affording such works First Amendment protection."⁴⁷⁹ The majority responded that the case before it involved a video game and thus "leaves room for distinguishing" it from "cases involving other kinds of expressive works."⁴⁸⁰ Third, during the oral argument in *Davis*, a Ninth Circuit judge

considering the "other background content of the game [as] secondary"), with *de Havilland v. FX Networks, LLC*, 230 Cal. Rptr. 3d 625, 641 (Cal. Ct. App. 2018), *cert. denied*, 139 S. Ct. 800 (2019) (considering both de Havilland's portrayed likeness in the television show and also the "creativity, skill and reputation" of the show's creators).

474. *de Havilland*, 230 Cal. Rptr. 3d at 637–39, 641.

475. *No Doubt*, 122 Cal. Rptr. 3d at 410–12, 415.

476. See *United States v. Santana-Dones*, 920 F.3d 70, 83 (1st Cir. 2019) ("The rule of Occam's razor teaches that the simplest of competing theories should often be preferred.").

477. At least one commentator appears to buy into this view, treating video games as having the same expressive value as sports cards. See Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN. ST. L. REV. 557, 571 (2007) (arguing that "nobody would suggest that [sports] players should not have the right to be compensated for the use of their identities in the video game and trading card markets because there is a legitimate social purpose in preventing unjust enrichment by the theft of good will"). One treatise also places video games in the same category as t-shirts, at least in the title. See Malla Pollack, *Litigating the Right of Publicity: Your Client's Face Was on the News, Now It's on T-Shirts and Video Games*, 119 AM. JUR. TRIALS 343 (2011).

478. *de Havilland*, 230 Cal. Rptr. 3d at 636, 641 (internal citations omitted).

479. *Keller v. Elec. Arts, Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268, 1290 (9th Cir. 2013) (Thomas, J., dissenting).

480. *Id.* at 1279 n.10 (majority opinion).

suggested greeting cards are “at least as expressive as a video game, probably more so.”⁴⁸¹ Fourth, even in *Brown v. Electronic Arts*, where the Ninth Circuit suggested that “any evolution” in the application of the First Amendment to video games merits “greater protection,”⁴⁸² the court nevertheless went out of its way to say “*Madden NFL* is not the expressive equal of *Anna Karenina* or *Citizen Kane*.”⁴⁸³

By contrast, recent statements recognizing video games as equal to other expressive works, such as the California Court of Appeal’s description of *San Andreas* as an “animated, interactive movie,” or Judge Thomas’s description of *NCAA Football* as a “work of interactive historical fiction,” are rare and often appear only in unpublished or dissenting opinions.⁴⁸⁴ In this sense, courts have regressed over time, given that one court had found in the early 2000s that video games are entitled to the same First Amendment protection as paintings, music, literature, and movies.⁴⁸⁵

The seemingly dominant view that video games are lesser than other expressive works and are instead comparable with “mundane products”⁴⁸⁶ or merchandise such as lithographs, t-shirts, and greeting cards stands in stark contrast to the U.S. Supreme Court’s recognition that the First Amendment protects video games just as much as it protects “the protected books, plays, and movies that preceded them.”⁴⁸⁷ The lower courts’ failure to properly categorize video games as expressive works can make all the difference, since one generally must obtain permission to use marks and likenesses on products and merchandise, while permission is unnecessary for expressive works.⁴⁸⁸

The perception of video games as products and merchandise might stem from a failure to understand that video games today are more complex than traditional games, such as *Chutes & Ladders*, or simple games, such as

481. See *supra* note 25 and accompanying text.

482. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 n.3 (9th Cir. 2013).

483. *Id.* at 1241. This comparison might not have been entirely serious; nevertheless, it gives the impression that the court believes the expressive value of video games cannot compare to the expressive value of books and films.

484. *Washington v. Take-Two Interactive Software, Inc.*, No. B232929, 2012 WL 5358709, at *1 (Cal. Ct. App. Oct. 31, 2012) (unpublished opinion); *Keller*, 724 F.3d at 1285 (Thomas, J., dissenting).

485. See *Interactive Dig. Software Ass’n v. St. Louis Cty.*, 329 F.3d 954, 957 (8th Cir. 2003).

486. *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012) (describing “mini-prints, mugs, cups, . . . flags, towels, [and] t-shirts” as “mundane products”).

487. *Brown v. Entm’t Merchs. Ass’n*, 131 U.S. 786, 790 (2011).

488. See *So Are Games Coffee Mugs or What?*, *supra* note 21, at 178; *Restoring Rogers*, *supra* note 21, at 311–12.

Pong.⁴⁸⁹ Even in the 1970s, adventure games such as *Zork* with characters, plot, and story much like those seen in books already existed.⁴⁹⁰ But by now, in the 21st century, the suggestion that modern video games are products or merchandise and not expressive works must be rejected as wrong except perhaps in the rarest of circumstances.⁴⁹¹ If the First Amendment protects the depiction of Olivia de Havilland in *Feud* and Jeffrey Sarver in *The Hurt Locker*,⁴⁹² it should likewise protect the depiction of Samuel Keller in *NCAA Football* and Michael Davis in *Madden NFL*.⁴⁹³

C. *Proposal to Apply the Rogers Test to Both Lanham Act and Right of Publicity Claims*

If a test must be applied at all to right of publicity claims,⁴⁹⁴ courts should apply the *Rogers* test, which strikes the right balance between the First Amendment, the Lanham Act, and the right of publicity. Courts have successfully applied the test to Lanham Act claims for more than thirty years since the Second Circuit decided *Rogers* in 1989. And the test is well-suited

489. See Ford & Liebler, *supra* note 21, at 4–5, 40 (describing McCarthy’s suggestion that “commercially produced games are largely unexpressive and mostly childish” and suggesting *Pong*’s “claim as expressive speech is not very compelling”); see also Jon M. Garon, *Playing in the Virtual Arena: Avatars, Publicity, and Identity Reconceptualized Through Virtual Worlds and Computer Games*, 11 CHAP. L. REV. 465, 472–73 (2008) (“[T]he makers of *Pong* had no point of view being espoused by their square ball or simple paddles”) (italics added).

490. See Ford & Liebler, *supra* note 21, at 57.

491. See Garon, *supra* note 489, at 472–73 (“[M]odern games can be violent, sexy, propagandistic, satirical or politically astute. At some point, the authors of these games tapped them for their expressive ability. The law has slowly followed suit.”) (footnote omitted).

492. See *de Havilland v. FX Networks, LLC*, 230 Cal. Rptr. 3d 625, 641 (Cal. Ct. App. 2018), *cert. denied*, 139 S. Ct. 800 (2019) (holding that FX’s use of *de Havilland*’s character was transformative and protected by the First Amendment); see also *Sarver v. Chartier*, 813 F.3d 891, 905 (9th Cir. 2016) (holding that *The Hurt Locker* was “fully protected by the First Amendment”).

493. See *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1176 (9th Cir. 2015) (alleging that the defendant included plaintiff’s likeness “without authorization” in its video game *Madden NFL*); *Keller v. Elec. Arts, Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268, 1271 (9th Cir. 2013) (affirming that the defendant’s “literal[] recreat[ion]” of the plaintiff in its video game “does not qualify for First Amendment protection as a matter of law”). Perhaps an even better comparison can be made to *Dryer v. National Football League*, 55 F. Supp. 3d 1181, 1204 (D. Minn. 2014), *aff’d*, 814 F.3d 938 (8th Cir. 2016), where the District of Minnesota dismissed retired football players’ right of publicity claims against the producers of football films because it found the films were expressive works and not commercial speech.

494. No balancing test is needed at all. Courts could simply apply the analyses in *Guglielmi, de Havilland*, and *Sarver*, to determine whether a publisher’s use of an individual’s likeness is a disguised commercial advertisement.

to the right of publicity context, where it would offer predictability and a less subjective test that would adequately protect video games as expressive works.⁴⁹⁵ The artistic relevance and explicitly misleading prongs of the test would give publishers the appropriate protection for their games, regardless of whether they depict real or fictional people, while preventing them from exploiting likenesses of real people as a disguised commercial advertisement.⁴⁹⁶ Assuming states have a legitimate interest in prohibiting certain unauthorized use of likenesses in expressive works, the *Rogers* test appropriately considers that interest without overreaching.⁴⁹⁷

Nevertheless, a mere proposal to apply the *Rogers* test is not enough since courts across the country have applied different versions of the test.⁴⁹⁸ While these inconsistencies require resolution, there is no need to overcomplicate the test. For example, one commentator suggested applying the *Rogers* test to right of publicity claims, but instead of analyzing whether the use of the likeness has artistic relevance, the proposed test would analyze whether the use has a “distinct expressive purpose.”⁴⁹⁹ As the commentator noted, however, that inquiry is still related to the transformative use test.⁵⁰⁰

Courts should simply apply a clear *Rogers* test that analyzes whether the use of the mark or likeness has artistic relevance to the work, and if so, whether the use explicitly misleads as to the source and content of the work.⁵⁰¹

495. See Yeo, *supra* note 438, at 426; Palachuk, *supra* note 438, at 259; accord TRADEMARKS AND UNFAIR COMPETITION, *supra* note 21, § 31:144.50 (“The yes-or-no rule [in the *Rogers* artistic relevance analysis] has the benefit of relieving judges of the need to make an artistic evaluation of how important the use of a trademark is in the defendant’s expressive work.”).

496. See *Rogers*, 875 F.2d at 999 (articulating the artistic prong and explicitly misleading prongs, and how they work together to protect the creator’s expressive work but not exploit the characters used for commercial gain); see also Palachuk, *supra* note 438, at 259 (explaining how the two prongs analyze “like and likeness” claims while providing broad protection to the creativity of the artistic work).

497. See Yeo, *supra* note 438, at 428, 433 (explaining that the artistic relevance prong gives “overriding weight to the public’s interest in free expression” while the second prong will not allow the defendant to use First Amendment protection “if the use amounts to an explicit false endorsement”).

498. See generally Jordan & Kelly, *supra* note 99, at 834–35 (noting the variety of ways the federal appellate courts have applied and refined the *Rogers* test); *Restoring Rogers*, *supra* note 21, at 307 (explaining the Second and Ninth Circuits’ expansion upon the original *Rogers* test); Zangrillo, *supra* note 446, at 403–21 (discussing the circuit split that developed over the *Rogers* test).

499. Yeo, *supra* note 438, at 431–32.

500. Yeo, *supra* note 438, at 431.

501. See Palachuk, *supra* note 438, at 259 (finding that it is advantageous for courts to use the two-prong test and analyze: “(1) whether the individual’s image and likeness is actually used; and (2)

When applying this test in the right of publicity context, courts can view the evidence through the lens of whether the use of the name or likeness is “‘wholly unrelated’ to the content of the work or is ‘simply a disguised commercial advertisement for the sale of goods or services.’”⁵⁰² The ultimate analysis remains roughly the same.⁵⁰³ This formulation of the *Rogers* test to right of publicity claims has generally been approved by courts,⁵⁰⁴ commentators,⁵⁰⁵ and the Restatement (Third) of Unfair Competition.⁵⁰⁶ And formulated in this way, the test would serve the purpose of trademark rights to avoid consumer confusion, the purpose of the right of publicity to prohibit unauthorized commercial misappropriation of an individual’s name or likeness, and the purpose of the First Amendment to protect expressive works.

The first part of the *Rogers* test would continue to focus on whether the use of the mark or likeness has artistic relevance to the underlying work. In the video game context, this has been and can often be a straightforward inquiry. As one court recognized, this requirement is “real,” but “not unduly rigorous” given the potential intrusion upon “First Amendment values.”⁵⁰⁷

whether the artistic work *intentionally or explicitly misleads* a consumer as to the source of the work”). The *Rogers* test can get complicated when applied to products and merchandise. See *Restoring Rogers*, *supra* note 21, at 311 (noting the complications with the medium of cards as expressive content). In a case involving the unauthorized use of the Honey Badger trademarks on greeting cards, the Ninth Circuit identified three additional considerations in analyzing the explicitly misleading prong: whether consumers would view the mark alone as identifying the source of the expressive work, the degree to which the user and the mark owner use the marks in the same way, and the extent to which the user adds its own expressive content to the work beyond the mark itself. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270 (9th Cir. 2018). Professor Ford discusses greeting cards in *Restoring Rogers*, *supra* note 21, at 311. The considerations stated in *Gordon* rarely apply in the video game context and show even more reason to treat video games less like products and merchandise, and more like other entertainment media. See *Restoring Rogers*, *supra* note 21 at 311–12.

502. See Kadri, *supra* note 441, at 1525–26 (footnote omitted) (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989)).

503. See Kadri, *supra* note 441, at 1530 (stating that even under the *Rogers* test, “public figures may still challenge unauthorized use in purely commercial expression” and “it disavows commercial exploitation through false endorsement”).

504. See *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003); *Matthews v. Wozencraft*, 15 F.3d 432, 440 (5th Cir. 1994); *Rogers*, 875 F.2d at 1004; see also *Dillinger, LLC v. Elec. Arts, Inc.*, No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678, at *4 n.1 (S.D. Ind. June 16, 2011) (applying the *Rogers* test); *Romantics v. Activision Publ’g Inc.*, 574 F. Supp. 2d 758, 765–766 (E.D. Mich. 2008) (recognizing that “[t]he Sixth Circuit applies the *Rogers* test to Lanham Act claims” and applying the *Rogers* test to the case at hand).

505. See Ford & Liebler, *supra* note 21, at 77–84; Palachuk, *supra* note 438, at 259.

506. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46, 47 & cmt. c (Am. Law Inst. 1995) (the Restatement’s exact formulation is different but functionally the same).

507. *AM Gen. LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467, 477 (S.D.N.Y. 2020).

Applied to a right of publicity claim, the First Amendment would protect the use of a likeness that has artistic relevance to the work but would not protect the use of the likeness that has no artistic relevance and is “wholly unrelated” to the work, since it then is “simply a disguised commercial advertisement.”⁵⁰⁸

The second part of the *Rogers* test would continue to focus on whether the use of a mark or likeness explicitly misleads consumers as to the source or content of the work. Courts should follow the lead of the Sixth and Ninth Circuits and scrap the likelihood of confusion and alternative means tests.⁵⁰⁹ In the video game context, the explicitly misleading test would thus primarily review whether the publisher made an “‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’” that would mislead a consumer as to the source or content of the work.⁵¹⁰ This appropriately balances the First Amendment with trademark law—concerned about consumer confusion—and with the right of publicity—concerned about the commercial misappropriation of likenesses. If the use of a name or likeness explicitly misleads as to the source or content of the work, “it is a disguised commercial advertisement.”⁵¹¹ But if it does not explicitly mislead, then the First Amendment should protect the use even though the publisher might benefit financially. This follows longstanding precedent that the First Amendment protects expressive works regardless of whether those works are for profit.⁵¹²

The Eastern District of Michigan’s decision in *Romantics* serves as a prime example of the proper application of the *Rogers* test to a right of publicity claim.⁵¹³ After finding that *Rocks the 80s* was an expressive work protected by the First Amendment, the court disposed of The Romantics’ right of publicity claim.⁵¹⁴ Because “the purpose of [*Rocks the 80s*] is to allow players to pretend they are in a rock band,” Activision’s use of the song was “not wholly unrelated to the content of the work.”⁵¹⁵ And because the song and The Romantics were not referenced in advertising materials, and one

508. See Kadri, *supra* note 441, at 1525 (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989)).

509. See *Parks v. LaFace Records*, 329 F.3d 437, 447–52 (6th Cir. 2003); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241–42 (9th Cir. 2013).

510. *Brown*, 724 F.3d at 1245 (quoting *Rogers*, 875 F.2d at 1001).

511. See Kadri, *supra* note 441, at 1525–26.

512. See *supra* notes 14–16 and accompanying text.

513. See *Romantics v. Activision Publ’g Inc.*, 574 F. Supp. 2d 758 (E.D. Mich. 2008); see also *supra* notes 175–186 and accompanying text (discussing *Romantics*).

514. *Romantics*, 574 F. Supp. 2d at 766.

515. *Id.*

could “play [*Rocks the 80s*] and never encounter the [s]ong,” it was not a “disguised commercial advertisement.”⁵¹⁶ The court’s straightforward analysis appropriately balanced the First Amendment’s protection of *Rocks the 80s* and The Romantics’ commercial interest in their likenesses.

Three final examples illustrate the potential application of this test to right of publicity cases. In *Parks v. LaFace Records*,⁵¹⁷ the Sixth Circuit found genuine issues of material fact as to whether OutKast’s use of Rosa Parks’s name as the title of a song that had “nothing to do with Parks” or her civil rights activities lacked artistic relevance and as to whether the song’s title was “wholly unrelated” to its content.⁵¹⁸ It concluded reasonable people “could find the title to be a ‘disguised commercial advertisement’ or adopted ‘solely to attract attention’ to the work.”⁵¹⁹ In *Brown v. Electronic Arts*, the Ninth Circuit’s hypothetical example of former NFL player Jim Brown’s name or likeness in a game called “*Jim Brown Presents Pinball* with no relation to Jim Brown or football beyond the title” might lack artistic relevance.⁵²⁰ Presumably, such a use would also be wholly unrelated to the work. And in *Guglielmi*, the California Supreme Court gave the hypothetical example of the defendants publishing “Rudolph Valentino’s Cookbook” where “neither the recipes nor the menus described in the book were in any fashion related to Rudolph Valentino.”⁵²¹

VI. CONCLUSION

This article’s review of cases involving the Lanham Act and the right of publicity in the video game context has revealed at least two necessary changes. First, it is beyond time for courts to apply the U.S. Supreme Court’s teaching in *Brown v. Entertainment Merchants Ass’n* and recognize video games as expressive works equal to traditional entertainment media instead of comparing them to mundane products and merchandise. Second, the transformative use test has failed to adequately apply First Amendment protection to video games, and courts should instead apply the *Rogers* test to both Lanham Act and right of publicity claims. By making these two changes,

516. *Id.*

517. *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

518. *Id.* at 452–53, 458, 461.

519. *Id.* at 461 (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1004–05 (2d Cir. 1989)).

520. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1244 (9th Cir. 2013) (italics added).

521. *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 457 n.6 (Cal. 1979).

video games might finally receive the First Amendment protection they deserve.

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Protecting the First Amendment Rights of Video Games

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